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Case No.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1983

PROFESSIONAL POSITIONERS, INC.

A WISCONSIN CORPORATION

PROFESSIONAL POSITIONERS, INC.

A DELAWARE CORPORATION

GERALD W. HUGE

RICHARD W. ALLESEE

PETITIONERS-DEFENDANTS,

VS.

T.P. LABORATORIES, INC.

AN INDIANA CORPORATION

RESPONDENT-PLAINTIFF.

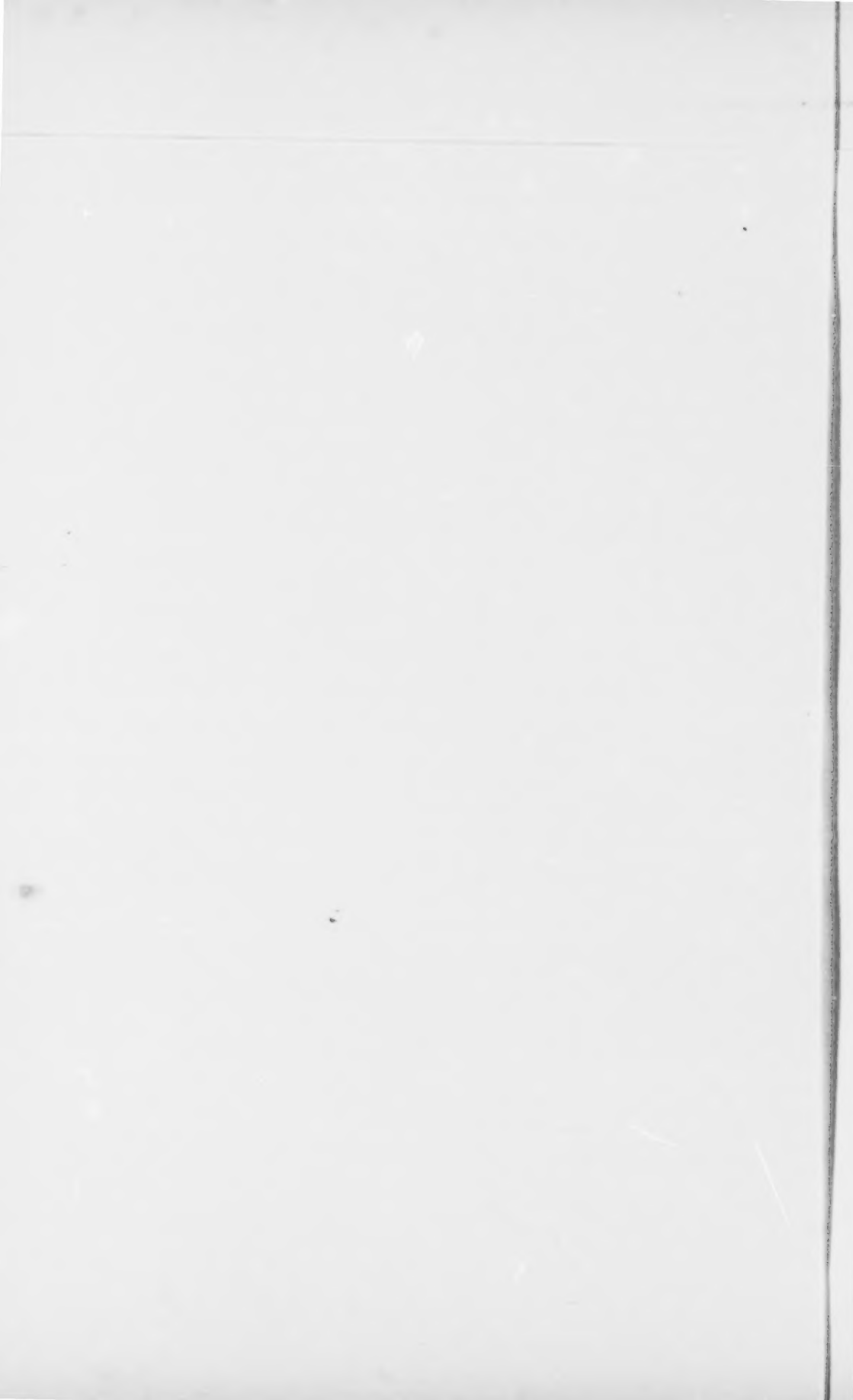
ON APPEAL FROM
THE COURT OF
APPEALS FOR
THE FEDERAL
CIRCUIT APPEAL
83-660 CROSS
APPEAL 83-680

PETITION FOR WRIT OF CERTIORARI

ALLAN B. WHEELER
606 W. WISCONSIN AVE.
MILWAUKEE, WIS. 53203
414-271-1318
414-278-7733

ATTORNEY FOR DEFENDANTS

44 pp



I. QUESTIONS FOR REVIEW

1. Should the patentee be freed of the burden of proving experimental use, where public use of an invention more than one year before the patent application has been proven? Did the Court of Appeals for the Federal Circuit properly change the long standing law on burden of proof to put the burden on defendants to dis-prove such experiment?
2. Was it proper for the Court of Appeals for the Federal Circuit to implicitly adopt a view of the facts contrary to that of the District Court without applying the standards of 52(a) FRCP, and without any opportunity to hear the personal testimony



of the inventor and others? Should it have remanded the case instead?

3. Does the period of permitted experimental use which does not offend 35 U.S. Code § 102(b) though it is more than one year before a patent application end when the claimed invention is demonstrated to be workable? Does it end with an admitted reduction to practice?

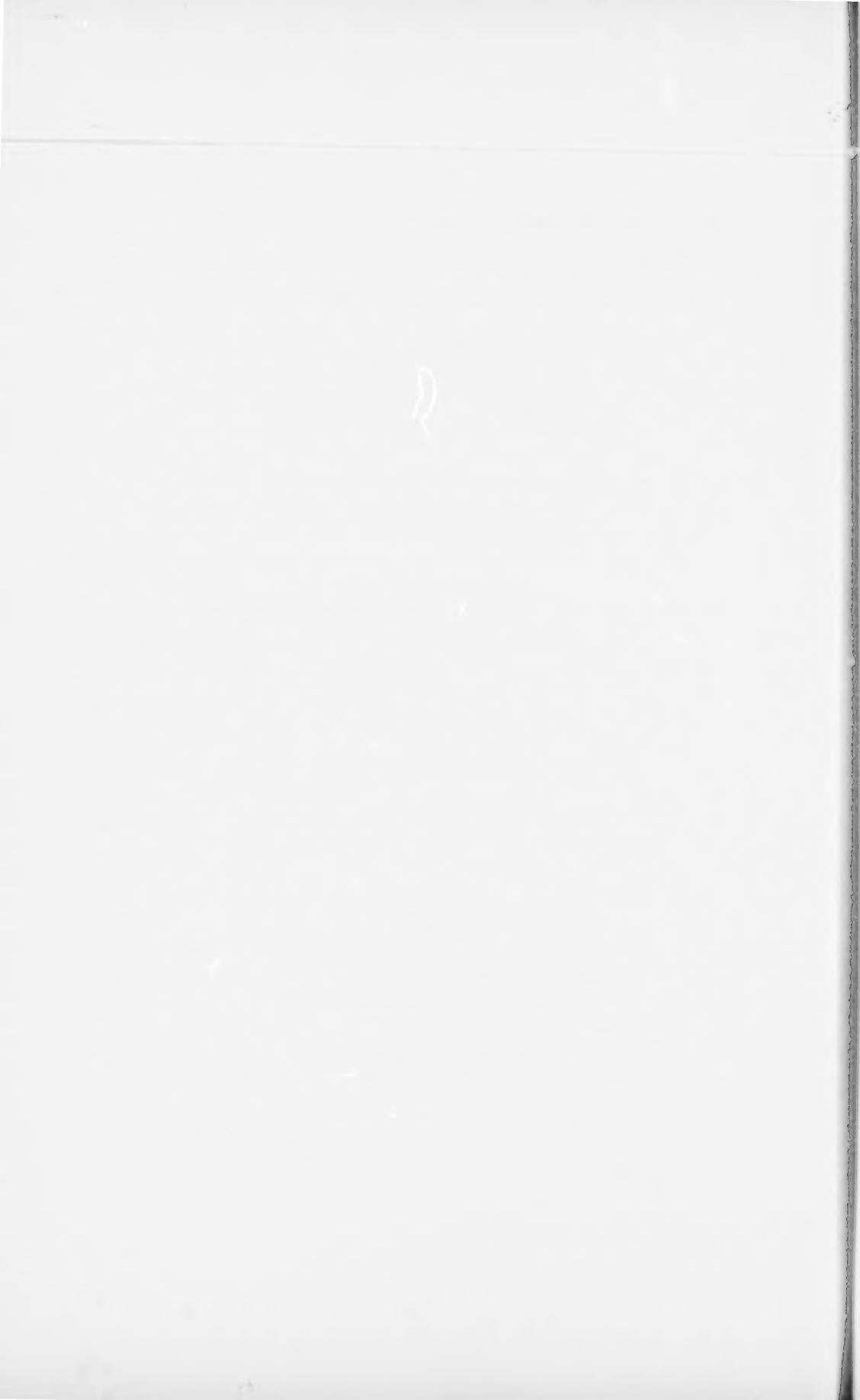
II. PARTIES

All parties are named in the case caption. Corporate defendant is a subsidiary of Bristol-Myers Company, a publicly held corporation of Delaware. Its subsidiaries are wholly owned.

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V. OPINIONS BELOW

The district court opinion is unreported but is found in the Appendix filed at the end of this Petition.

The Opinion of the Court of Appeals for the Federal Circuit is reported at 220 United States Patent Quarterly 577. It is not yet reported elsewhere. It is found in the Appendix hereto.

VI. JURISDICTION

The jurisdiction of the U.S. Supreme Court is based on 28 U.S. Code § 210(c) and 28 U.S. Code § 1254. The date of the decision of the Court of Appeals for the Federal Circuit was January 4, 1984.

VII. STATUTES

35 U.S. Code § 102(b). Conditions for patentability; novelty and loss of right to patent



A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U.S. Code § 282(2). Presumption of validity; defenses

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability.

VIII. STATEMENT OF THE CASE

A. Jurisdiction

Jurisdiction of the federal courts is based on 35 U.S. Code § 281; 28 U.S. Code § 1331; and 28 U.S. Code § 1295.

B. Decision of District Court

The district court held that defendants had the burden of proving by clear and convincing evidence that public use of the patented invention had occurred more than one year before the patent application for the patent in suit was filed. It found that such use was clearly established and that the users were not under any obligation of secrecy to the inventor. It found no contrary evidence.

Having so found, it placed the burden of proving any exception to take the uses out of the category of public uses prohibited by 35 U.S. Code 102(b) upon the patentee (plaintiff). The agreed facts submitted before trial included plaintiff's statement that reduction to practice occurred in 1956. The evidence in the case was analyzed by the court, including the testimony and conduct of the inventor (now deceased) and the court held



that there was not experimental use as to at least the last two proven uses earlier than the statutory bar date.

C. Decision of the Court of Appeals
for the Federal Circuit

The Court of Appeals held that the District Court had incorrectly placed the burden of proof of experimental use on plaintiff (patentee). In so doing it upset settled law on the point as discussed below.

It then reversed the judgment of the District Court on invalidity, and held the prior uses experimental without remand to the trier of facts and without full analysis of the findings and record under Rule 52(a) FRCP. It gave no effect to plaintiff's admitted reduction to practice of the invention in 1956 before any of the proven public uses.



IX. ARGUMENT

A. The Burden of Proof Was Decided Contrary to Settled Law.

The Court of Appeals has held that defendant is responsible not only for proving that there was a public use, but that it was not within any exception to 35 U.S.C. § 102(b). The structure of the statute does not support such a reading. Despite the fact that the statute was completely rewritten in 1952 to codify the patent law, there is not one word in the statute concerning the experimental use exception. The statutory condition is that if public use has occurred more than a year before the filing of a patent application, that patent application is barred. There are a great many cases that lay a heavy burden on a defendant to prove that such a use has occurred before a patent will be invalidated for this reason. There is also a long line of cases holding that if even one such use is proven, the patent cannot survive.

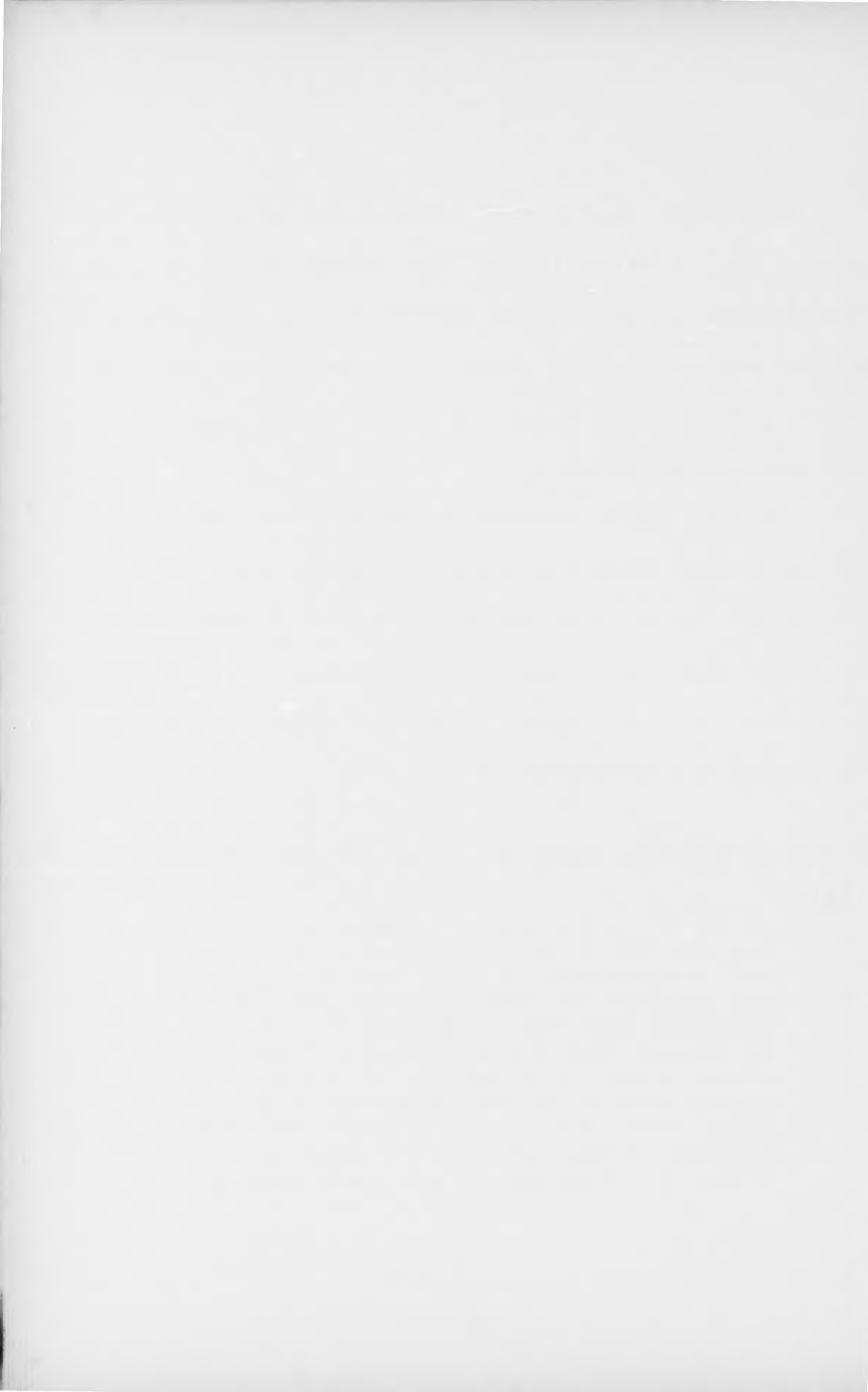


Most of the cases also hold that once a public use is established, the burden of proof or the burden of persuasion shifts to the inventor to allege and prove that there is an exception to the rule stated in 35 U.S.C. § 102(b) which applies to the particular patent.

It has been thought to be settled law in the United States that the burden of proof was on the inventor to establish by clear and convincing evidence that the occurrence should not be a bar because, for instance, it was an experiment. The following are illustrative:

Stewart-Warner Corp v. City of Pontiac, Mich.,
717 F.2d 269, 219 U.S.P.Q. 1162 at 1165 (CA-6,
1983):

In this Circuit, a party challenging the validity of a patent based on the statutory bar of 102(b) carries the burden of making a prima facie showing that the invention was on sale by clear and convincing evidence. Once such a showing is made, the burden shifts to the patentee to prove that the device was not on sale because it was not functionally operative, or because it was used only for



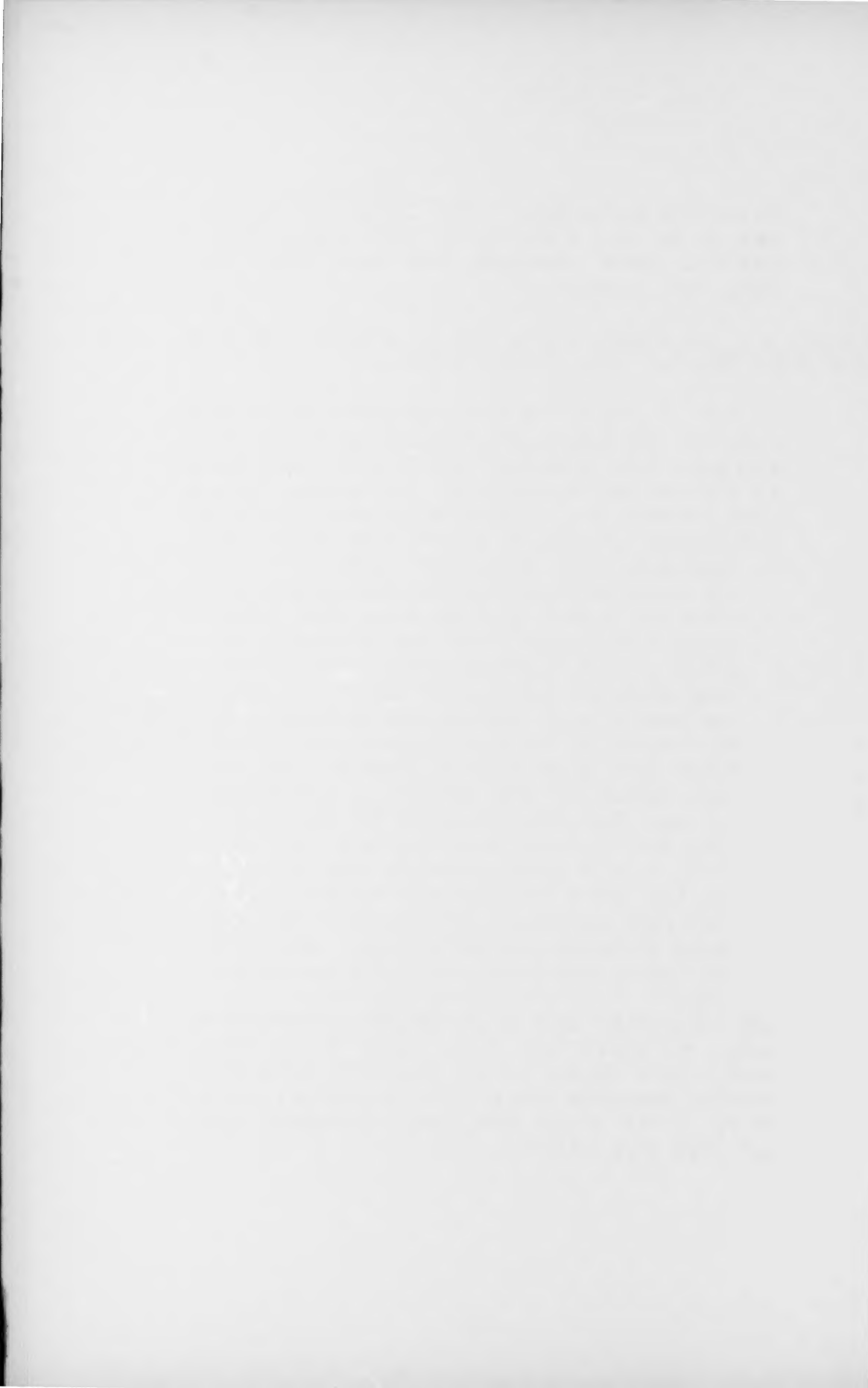
testing purposes. FMC Corp. v. Myers, 384 F.2d 4, 155 USPQ 299 (6th Cir. 1967), cert. denied, 390 U.S. 988, 157 USPQ 720 (1968).

Kock v. Quaker Oats Co., 681 F.2d 649, 215 U.S.P.Q. 200 at 204 (CA-9, 1982):

To insure that abuses section (102(b) is designed to prevent do not arise, the burden of proof that sale is for an experimental purpose is on the inventor. The Supreme Court so indicated in Smith & Griggs Mfg. Co. v. Sprague, 123 U.S. 249 (1887):

In considering the evidence as to the alleged prior use for more than two years of an invention which, if established, will have the effect of invalidating the patent, and where the defense is met only by the allegation that the use was not a public use in the sense of the statute, because it was for the purpose of perfecting an incomplete invention by tests and experiments, the proof, on the part of the patentee, the period covered by the use having been clearly established, should be full, unequivocal, and convincing.

Id. at 264; see also Omark Industries, Inc. v. Carlton Co., 652 F.2d 783, 787, 212 USPQ 413, 416-417 (9th Cir. 1980); Aerovox Corp. v. Polymet Mfg. Corp., 67 F.2d 860, 861, 20 USPQ 119, 120 (2d Cir. 1933).



Norfin v. IBM, 625 F.2d 357, 207 U.S.P.Q. 737 at 739:

. . . In McCullough Tool Company v. Well Surveys, Inc., 343 F.2d 381, 145 USPQ 6 (10th Cir. 1965), cert. denied, 383 U.S. 933 (1966), 148 USPQ 772 we observed:

. . . The burden is upon the one asserting prior public use to establish it by clear, cogent and satisfactory proof to remove all reasonable doubt thereof; but when a use is shown that has occurred prior to the statutory period, it is incumbent upon the patentee to show that such use was experimental only. [Citations]. The issue of whether a use of the device is experimental or public is one of fact. [Citations]. And, the trial court's finding in this respect is binding upon the Court of Appeals unless it is clearly erroneous.

DeLong Corp. v. Raymond International Inc., 622 F.2d 1135, 206 U.S.P.Q. 97 at 104 (CA-3, 1980):

. . . When, however, the inventor has chosen to sell his invention more than one year prior to the date of the patent application the presumption is, in the absence of evidence to the contrary, that the experimental period is over and that the invention is suitable for commercial exploitation. The burden of proof then shifts to the inventor, for as the court stated in

Koehring Co. v. National Automatic Tool Co., 362 F.2d 100, 104, 149 USPQ 887, at 890-891 (7th Cir. 1966), "once a single use of an operative device embodying the invention prior to the critical date has been shown the inventor must carry the burden of proving that the use was part of a bona fide program of experimentation."

Paeco, Inc. v. Applied Moldings, Inc. et al., 562 F.2d 870, 194 U.S.P.Q. 353 at 357 (CA-3, 1977):

In the case sub judice, the district court found that Paeco had failed to meet its burden of showing by clear and convincing evidence that the public sale of the Colony beam prior to the critical date was experimental in nature, motivated by a desire to perfect or improve the invention. We may disturb this finding of fact by the district court only if clearly erroneous. However, we find no clear error here.

Red Cross Mfg. Corp. v. Toro Sales Co., 525 F.2d 1135, 188 U.S.P.Q. 241 at 244 (CA-7, 1975).

The policy underlying the "on sale" bar is to prevent an inventor from holding back the secrets of his invention from general public knowledge while at the same time exploiting it commercially, thereby extending the duration of his legal monopoly. Koehring Co. v. National Automatic Tool Co., 362 F.2d 516, 520 68 USPQ 54, 58 (2nd Cir. 1946); see generally,

New Guidelines for Applying the On Sale Bar to Patentability, 24 Stan. L. Rev. 730, 733-34 (1972). Under the statute, an existing patent is presumed to be valid. 35 U.S.C. § 282. When the objection is asserted, the burden of establishing that the patented product was "on sale" before the critical date is on the objector. *Dart Industries, Inc. v. E.I. Dupont de Nemours and Co.*, 489 F.2d 1359, 1364, 179 USPQ 392, 395-396 (7th Cir. 1973), cert. denied, 417 U.S. 933, 179 USPQ 392. This burden must be satisfied by clear and convincing evidence. *Minnesota Mining & Mfg. Co. v. Kent Industries, Inc.*, 409 F.2d 99, 100, 161 USPQ 321, 322 (6th Cir. 1969). Once such activity has been successfully established, invalidity may be avoided by showing that the sales activity was "substantially for purposes of experiment." *Smith and Griggs Mfg. Co. v. Sprague*, 123 U.S. 249, 256 (1887). The burden of proving experimental purpose rests with the inventor and must be met with "full, unequivocal, and convincing evidence. *Id.* at 264.

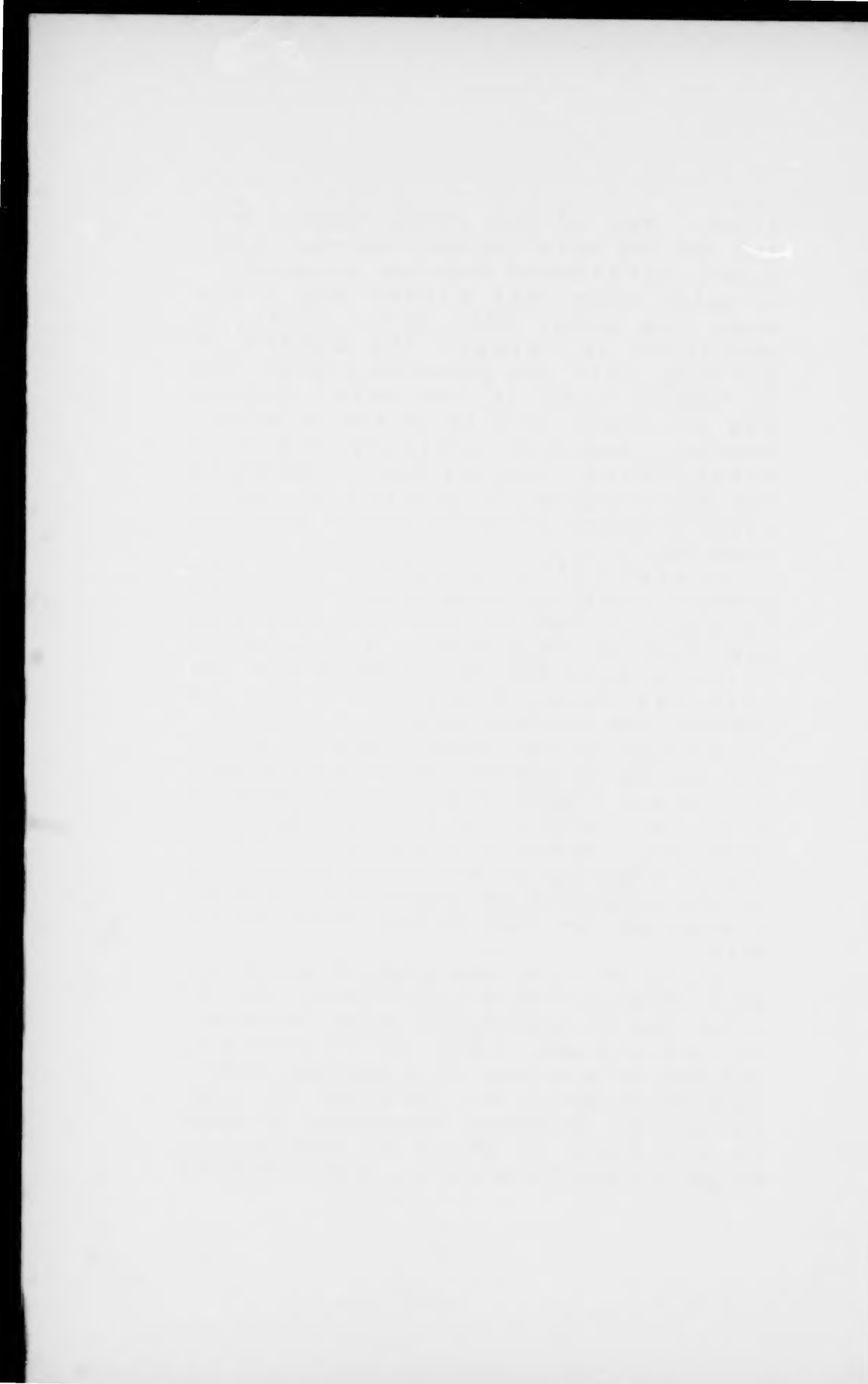
Dart Industries v. E.I. du Pont de Nemours & Co., 489 F.2d 1359, 179 U.S.P.Q. 392 at 396 (CA-7, 1973):

We first note that § 102(b) contains several distinct bars to patentability, each of which relates to activity or disclosure more than one year prior to the date of the applica-

tion. Two of these--the "public use" and the "on sale" objections--are sometimes considered together although it is quite clear that either may apply when the other does not. If either objection is raised, the burden of proving that the patented product was in "public use" or "on sale" before the critical date is on the objector. However, once such activity has been established, the burden of avoiding the statutory bar by proving a purely experimental purpose rests upon the inventor. . . .

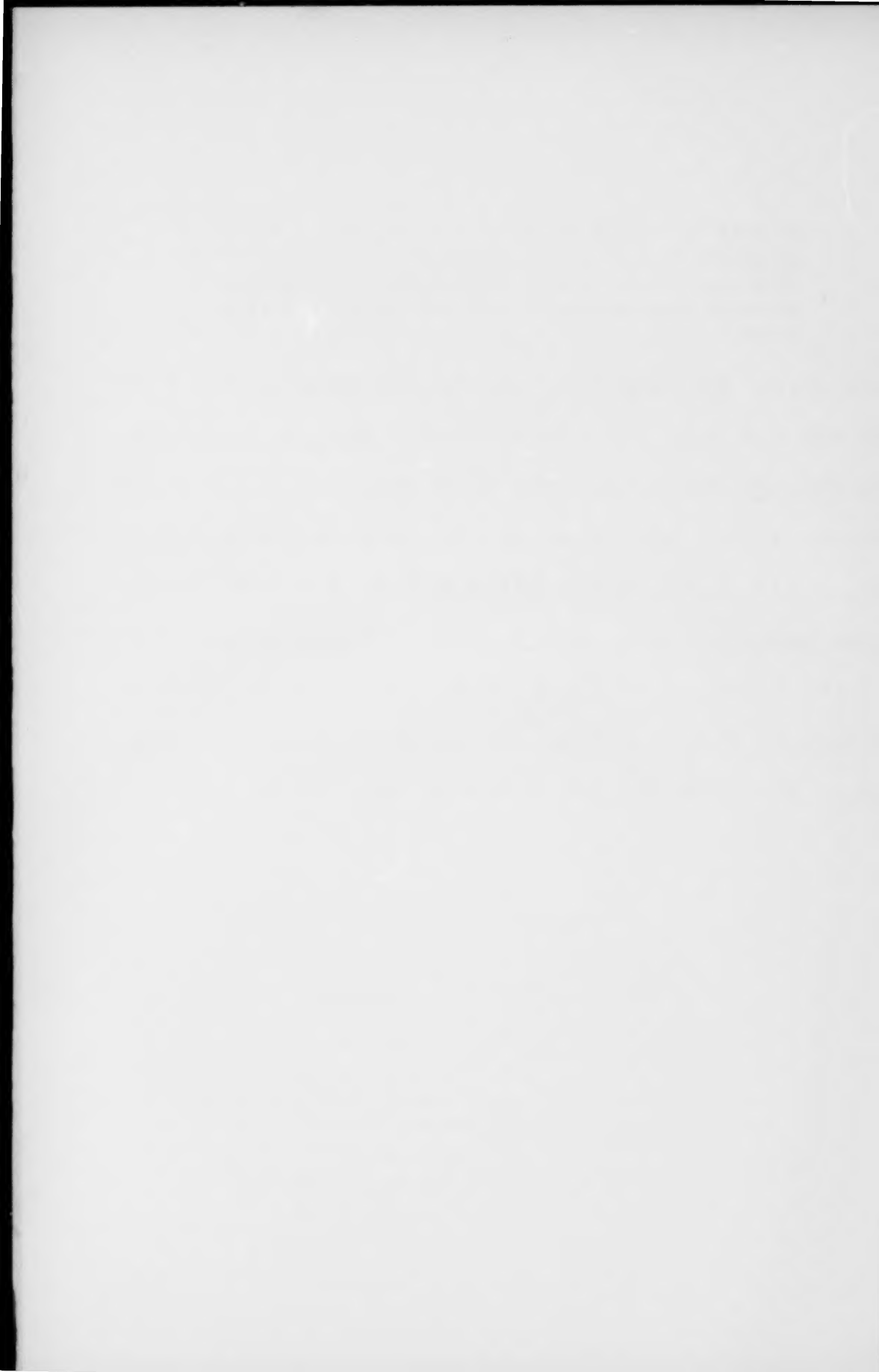
Plaintiff's argument that the product could not have been "on sale" because it had not yet been completed must also be rejected. In cases in which a sale has been made before the critical date, a typical issue is whether the product sold is sufficiently similar to the product described in the claims to invoke the statutory bar. See, e.g., *Frantz Mfg. Co. v. Phenix Mfg. Co.*, 457 F.2d 341, 318-323, 173 USPQ 266, 269-273 (7th Cir. 1972). Exact identity is not required as long as the invention is essentially completed at the time of the invalidating sale.

In this case, the product which was sold underwent no significant change after the disqualifying sales occurred. It had already been sufficiently reduced to practice to avoid the reference dated April 25, 1951; and it subsequently achieved commercial success in the form in which it was sold. More significantly, even though



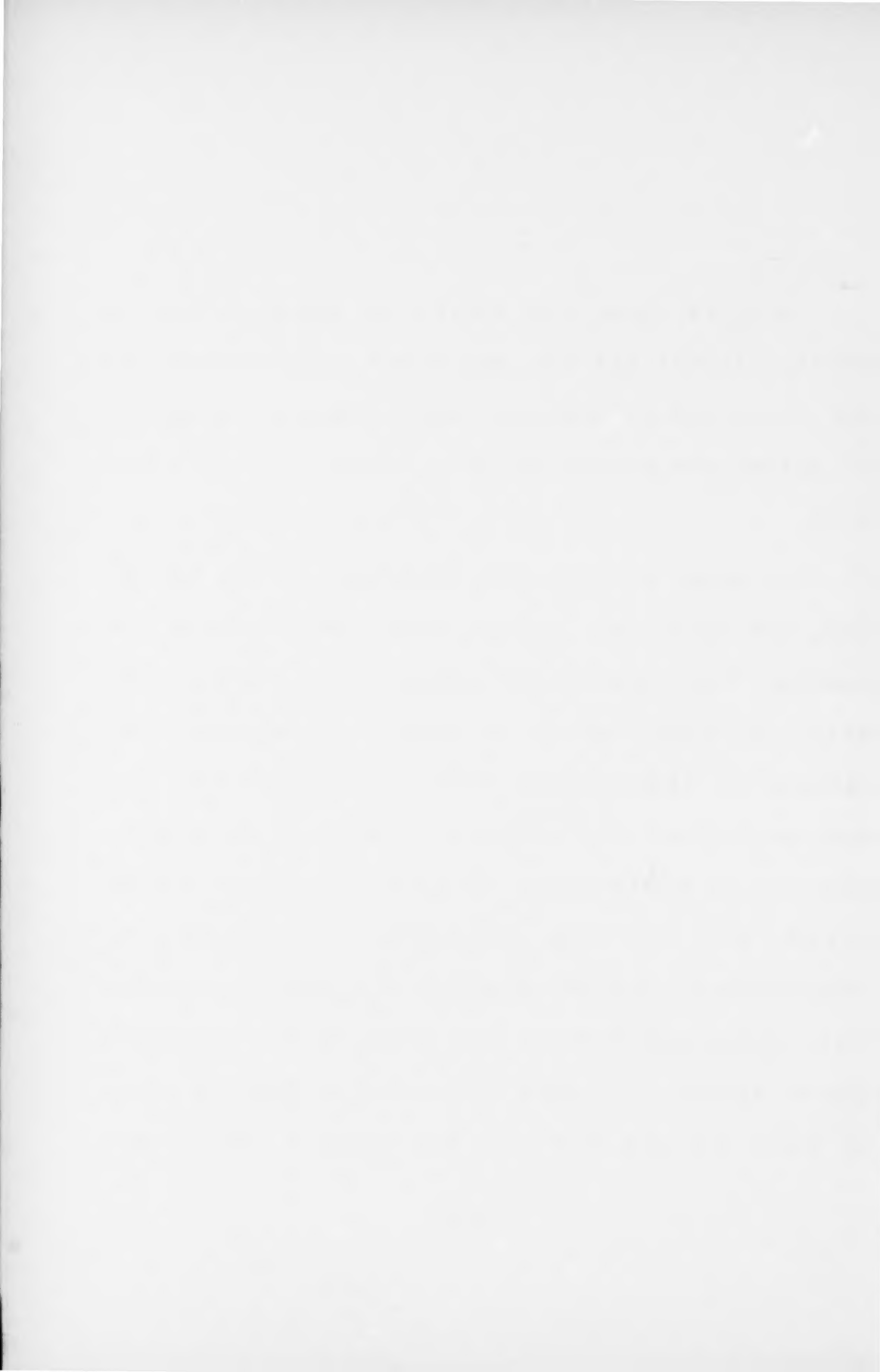
Bradt's laboratory tests could not guarantee ultimate commercial acceptance, they were sufficient to demonstrate the workability of his conception.

See also Scharmer v. Carrollton et al., 525 F.2d 95, 187 U.S.P.Q. 736 (CA-6, 1975); Dunlop Co. Ltd. v. Kelsey-Hayes Co., 484 F.2d 407, 179 U.S.P.Q.129 (CA-6, 1973); Strong et al. v. General Electric Co., 434 F.2d 1042, 168 U.S.P.Q. 8 (CA-5, 1971); Ajem Laboratories, Inc. v. Centri-Spray Corp., 424 F.2d 1124, 165 U.S.P.Q. 737 (CA-6, 1970); Minnesota Mining & Mfg. Co. v. Kent Industries, Inc., 409 F.2d 99, 161 U.S.P.Q. 321 (CA-6, 1969).



In this case the Court of Appeals for the Federal Circuit has not resolved a conflict, it has reversed a long-standing current of authority and placed the burden of proof where it ought not to be.

The cases dealing with experimental use establish, among other things, that the intent of the inventor, the presence or absence of commercial activity, the presence or absence of secrecy, the presence or absence of records concerning the experimentation, the presence or absence of experimentation on variations of the structure being tested, and the like, are all indicia relevant to a determination of whether there has been bona fide experimentation concerning the claimed subject matter (not some orthodontic device that has been in use for many use prior to the inven-

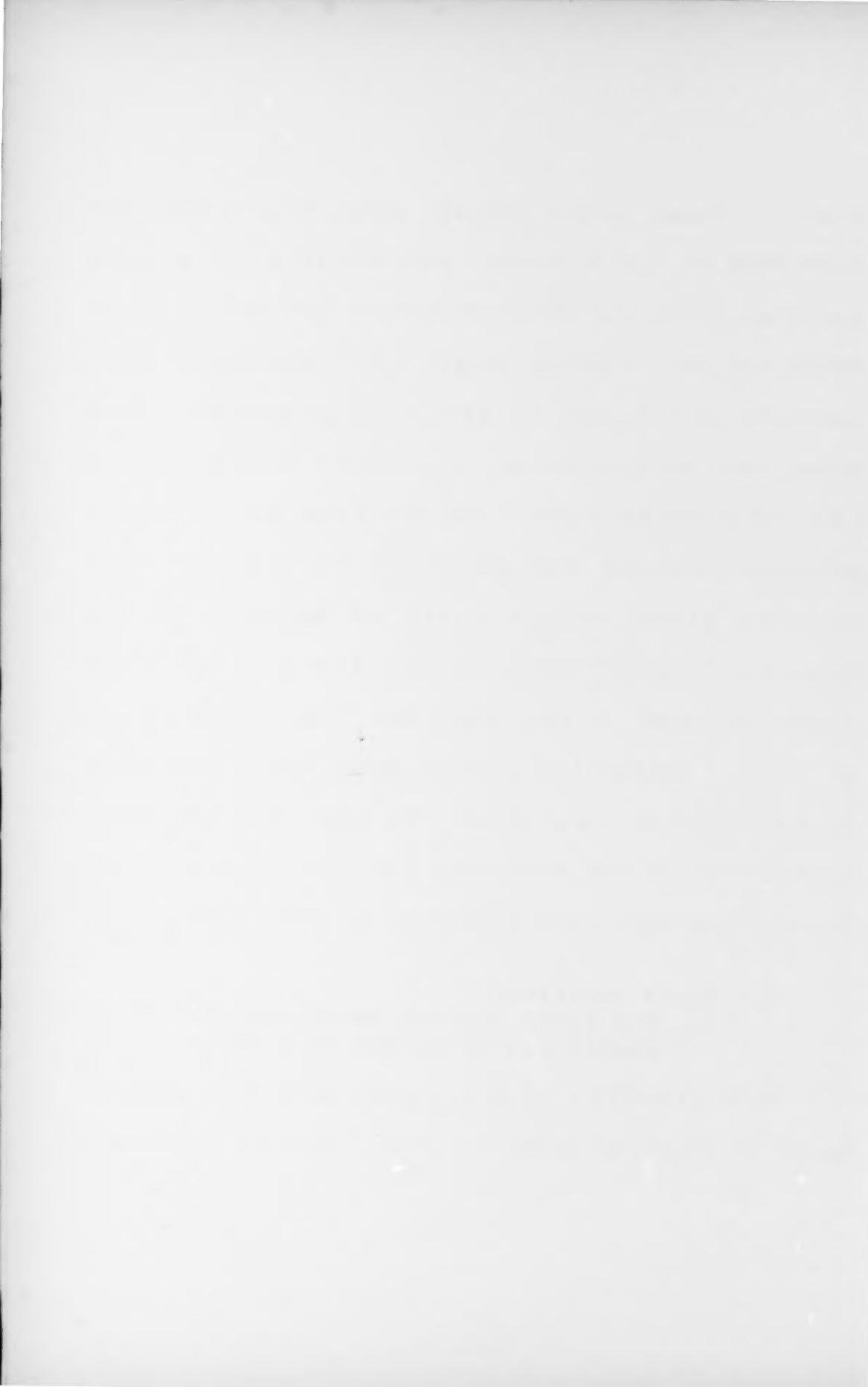


tion). These things are all peculiarly within the knowledge of the inventor, particularly in a case such as this one where defendant has had to fight tooth and nail even to obtain the knowledge that records exist and to get them produced. Even after they were produced, plaintiff would change its testimony from time to time as to which patients received the patented structure. The figures given in the Court of Appeals for the Federal Circuit opinion are derived not from rigorous proof in the case, but from a compilation of unknown authenticity as to which there has been no definitive testimony. We know that the three cases prior to the statutory bar date exist. We do not know what others existed at that time.

B. Facts Amplified

1. The facts support petitioner ,
regardless of burden of proof.

The District Court found as a fact that by April of 1959 the inventor, Dr. Harold Kesling,



knew that the claimed "precision seating springs" of Figure 7 of the patent operated as designed. This was confirmed when he treated Susan Spiers and Sheila Rumely. It found that the record card DX 277 indicated favorable results as early as February 1960. (District Court Decision Appendix page 21).

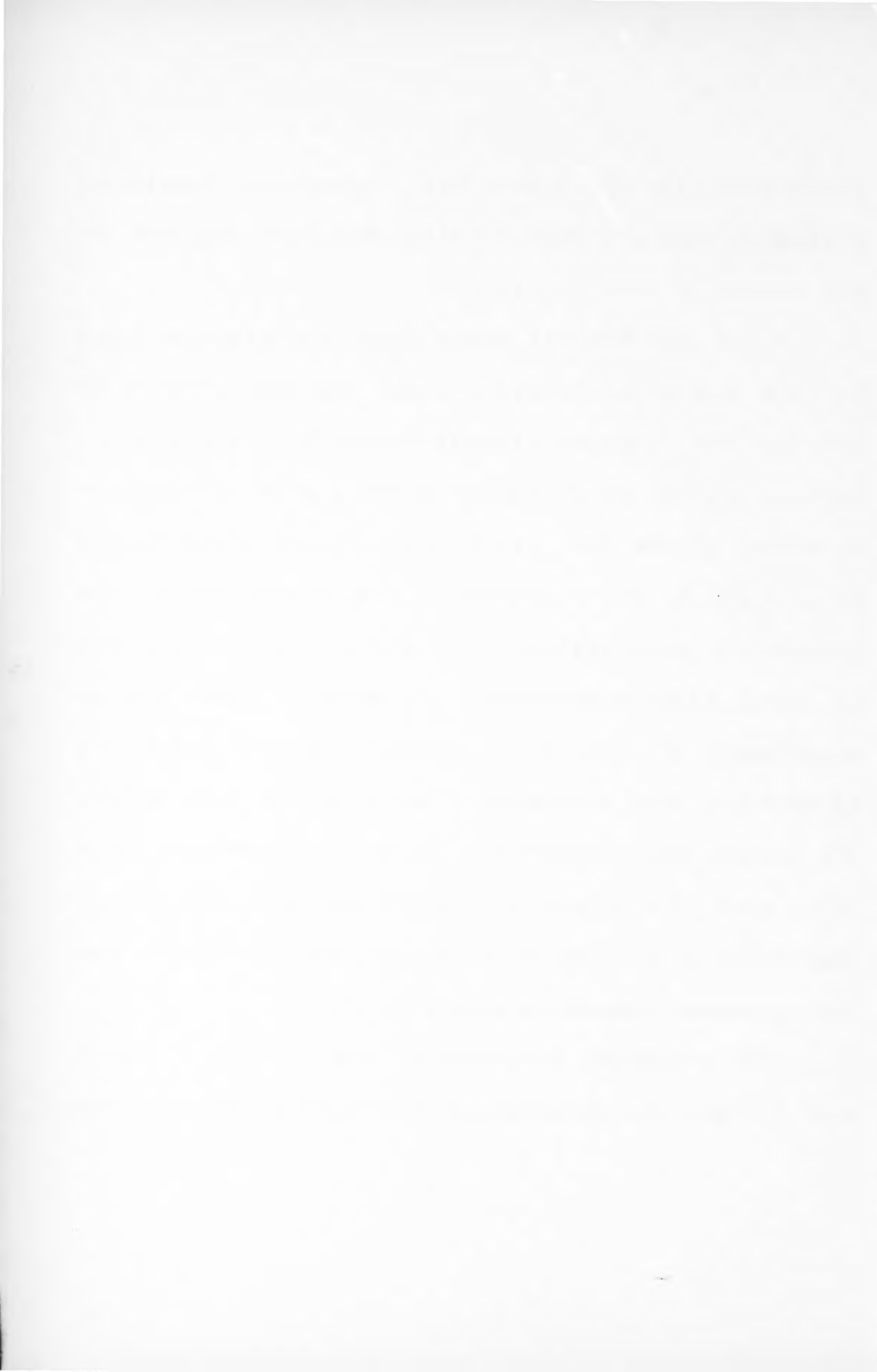
The inventor himself testified that there was no change in the device for the purpose of experiment or otherwise, from the time he began treating Nancy Furst until the time the patent application was filed disclosing the same device in Figure 7 (Appendix page 21).

The District Court held that the delay was unreasonable because the device proved satisfactory immediately. (Appendix page 21-22) At that point his time began to run under 35 U.S.C. § 102(b). The court held that when an experiment tolls § 102(b) the one year period of limitation

commences to run when the invention disclosed proves workable. That holding did not depend on the burden of proof issue.

There are several basic fact determinations by the District Court, which had the benefit of hearing the inventor himself testify, (an opportunity which will never come again since the inventor is now deceased) and which also heard testimony by other orthodontists in and out of the inventor's partnership. It held: (1) there was no bona fide experiment, (2) even if there was an experiment it led to a determination that the invention was successful well over a year before the patent application was filed. (Appendix page 22), and (3) plaintiff's delay without either improving or filing his patent application was unreasonable (Appendix pages 20-22).

The procedure followed by the District Court was first, to determine whether a use that was



public in fact occurred and second, to determine whether such use was not a "public use" within 35 U.S.C. § 102(b) because it was experimental within the meaning of Elizabeth v. American Nicholson Pavement Co., 97 U.S. 126 (1877). (Appendix pages 16-17). This procedure is in accord with the ruling of the Court of Appeals for the Federal Circuit.

The District Court found that the burden of proof of public use is on the defendant in a patent infringement case. That also accords with the holdings of the Court of Appeals of the Federal Circuit. (Appendix page 18). The court then went on to hold (Appendix pages 18-19):

The evidence in this case clearly establishes use by at least three patients more than one year prior to the application date. Furthermore, these users were 'under no limitation, restriction or obligation of secrecy to the inventor.' . . . Certainly there is no evidence to the contrary and there is testimony to support such a finding. (DX 355 - deposition of Dr. B.L. Furst) Nancy Furst's father at

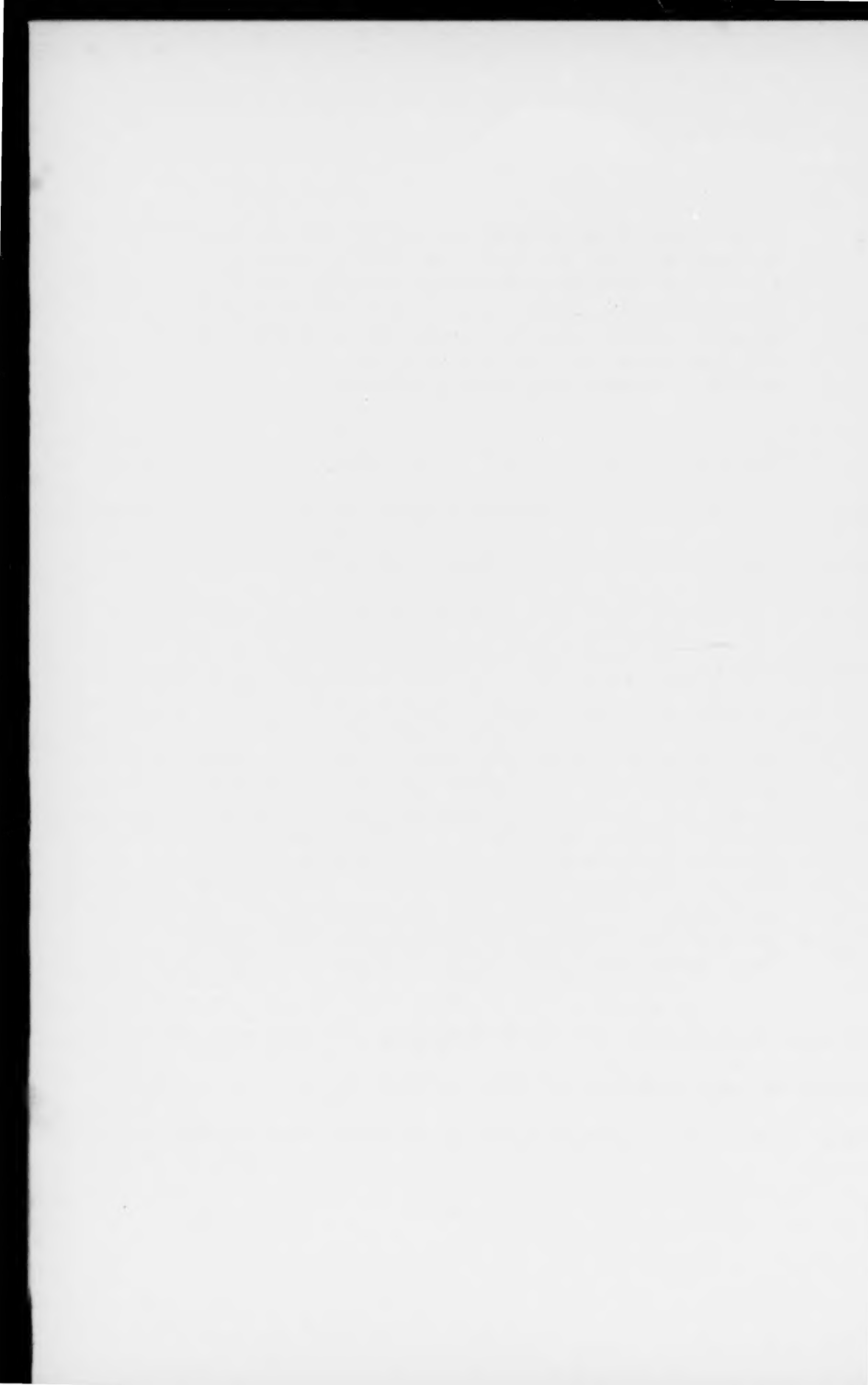
9); (DX 356 - deposition of Susan Spiers Elliot at 7); (DX 357 - deposition of Sheila Rumely Brady at 7). Consequently, the court can only conclude that the patients were under no obligations of secrecy, or for that matter, under any restrictions.

The court also had the opportunity to hear the inventor himself testify that he did not place these patients or their families under any obligations of secrecy nor under any obligation of reporting as to how the invention worked.

The court further held:

The plain fact is that the claimed invention was not kept secret. It was open to public observation without restriction which is sufficient to constitute public use. (Appendix page 19). Consequently, the feigned secrecy relied upon by TP accords it no aid in claiming that the 'use' was not 'public.'

These holdings do not depend in any way on the court's application of the burden of proof and in any case, the court indicated that the burden was



on the defendant when it made these holdings. The court then went on to analyze the experimental use exception. It did hold at that point that the inventor bears a heavy burden of showing that the public use was bona fide experimentation. (Appendix page 20). (citing cases). It further held that an inventor is only permitted a reasonable period of experimentation. It then went on to hold the experimental use exception unavailable to plaintiff TP. Its findings of fact on that branch of the case were as follows

(Appendix page 20-21)

First, the evidence presented does not establish that the patentee was conducting a bona fide experiment. On the contrary, the record shows that the uses were random and poorly monitored. The only records kept by Dr. H. Kesling were the patient records. Dr. H. Kesling, the inventor, did not always evaluate how well the precision seating springs worked when the patients visited the clinic. Other doctors often made evaluations of performance. Furthermore, while the issue of experimentation is in effect a matter of the inventor's



intent, in the present case the evidence indicates that his intent was not experimentation. In experimenting on a prior "invention," Dr. H. Kesling kept accurate records of the results of his experiments. In the present case, the records are scanty at best. (Tr. at 967). . . . the dearth of such records indicate that the use was not an experiment.

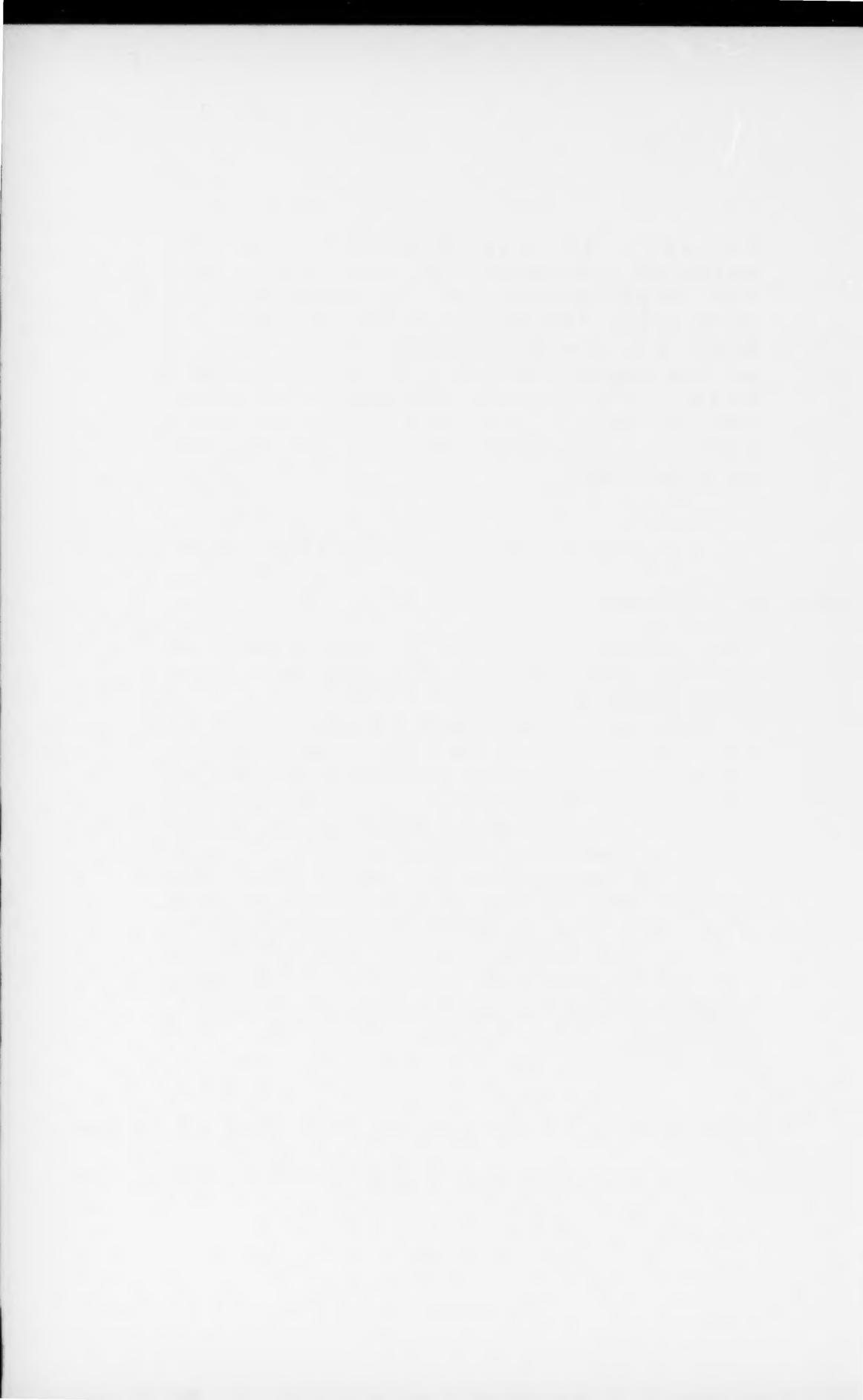
Its holdings of law (Appendix page 20-21) were as follows:

The inventor bears a heavy burden of showing that the public use was bona fide experimentation. . . .

The experimental exception is further limited in time. An inventor is only permitted a reasonable period of experimentation. . . . Whether or not the use was experimental is, however, a question of fact. . . .

It is important to note that the burden was on the plaintiff TP to show that use was a genuine experiment. . . . The experimental use exception 'is to be guarded closely.' Atlas Chemical Industries, Inc. v. Moraine Products, 184 U.S.P.Q. 281, 283 (6th Cir. 1974).

Separately it went on to hold that if it was assumed that the use was experimental that the



delay in filing the patent application was unreasonable. (Appendix page 21).

The court held on undisputed facts that the invention was used in August of 1958 and that by April of 1959 Dr. H. Kesling knew that the precision seating springs operated as designed, which was confirmed when he treated Susan Spiers and Sheila Rumely. The Spiers' positioner was placed in November of 1960 and the Rumely positioner was placed in November of 1959. The District Court held that the record card indicated favorable results as early as February of 1960.

Nevertheless, Dr. H. Kesling waited until February 19, 1962 to file his patent application. Significantly, the claimed invention disclosed in Figure 7 of the patent in suit is substantially the same as the precision seating spring disclosed in the positioner (DX 266) supplied to Nancy Furst in August of 1958. Finally, Dr. H. Kesling, the inventor, himself testified that the precision seating springs supplied to Furst, Spiers and Rumely were substantially the same as those disclosed in Figure 7 of the patent in suit. (Tr. at 1039-40).



The delay here was unreasonable because the device proved satisfactory immediately. At least early as 1960 Dr. Kesling learned that the invention was workable.

The court went on to make a finding of law:

At that point his time began to run under 35 U.S.C. § 102(b). . . . This Court is of the opinion that when an experiment tolls section 102(b), the one-year period of limitation commences to run when the invention disclosed proves workable. . . . The evidence indicates, however, that not even novel changes were made in the basic conception in public use in 1960.

Whether this Court finds the period of experimentation unreasonably long or that Dr. H. Kesling did not conduct a bona fide experiment, the public use, as found earlier, occurred more than one year prior to the filing date of the patent application. Under 35 U.S.C. § 102(b), this public use of the basic concept invalidates the patent in suit.

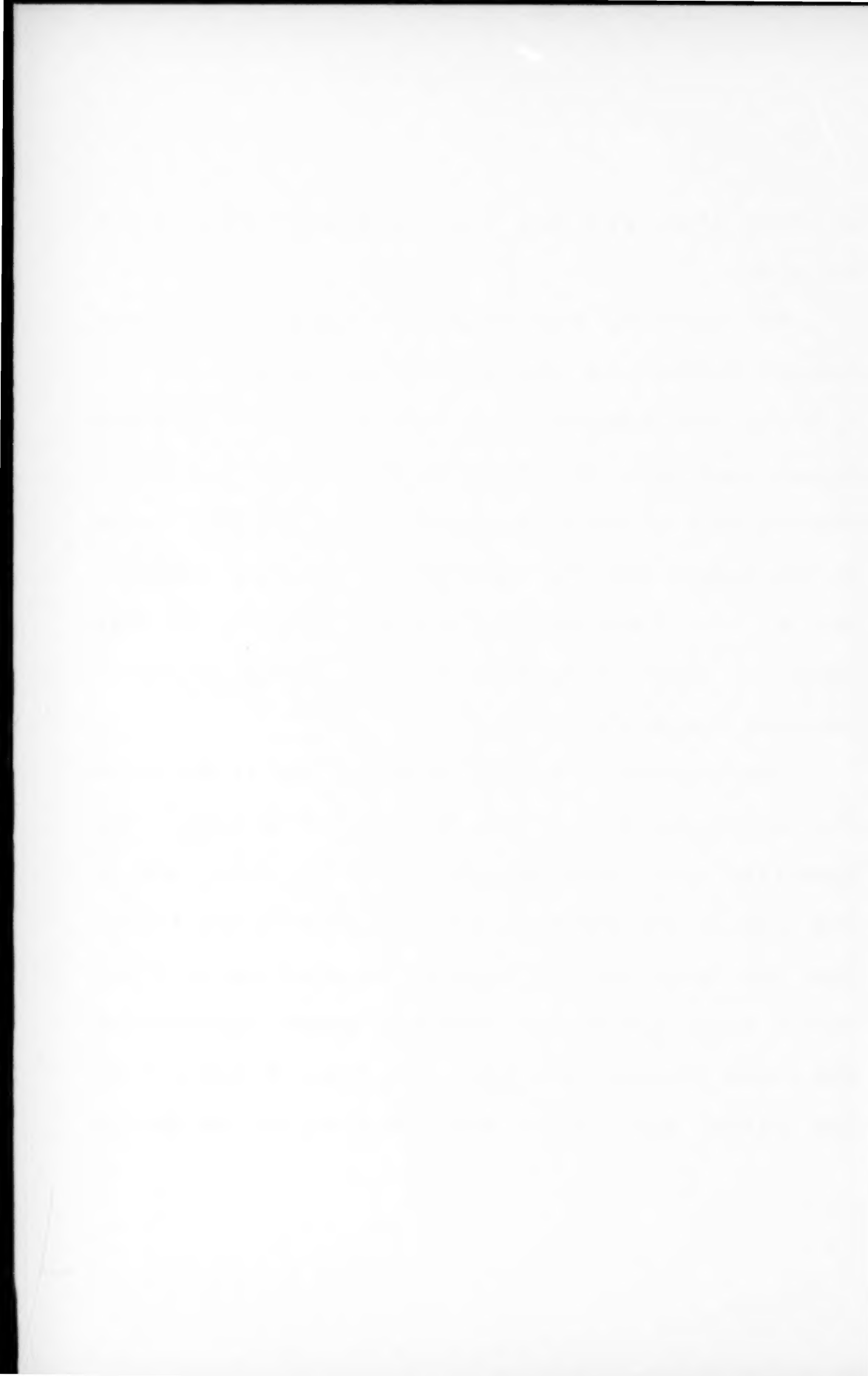
The Court specifically held at Appendix page 23 that all other issues of infringement and validity were made moot by these holdings and did not need to be decided. If the Court's decision is over-



turned they are not moot and will require a decision.

As held by the Court of Appeals for the Federal Circuit in the second paragraph of its opinion "TP admits that the inventor used the dental appliance on three orthodontal patients during the critical period." Thus the only issue on the appeal was the application of the experimental use doctrine, not the use itself. On that issue the Court of Appeals for the Federal Circuit reversed the District Court.

The grounds given for reversal had to do with the application of the burden of proof. The Appellate Court made no mention of the fact (which was one of the admitted facts preceding the trial) that the invention was reduced to practice in 1956. It is also undisputed that the patent application was filed February 19, 1962 and that Figure 7 of the patent application was identical to the device



made in 1956 and the devices tested in 1958 and following, concerning which TP asserts the experimental use exception.

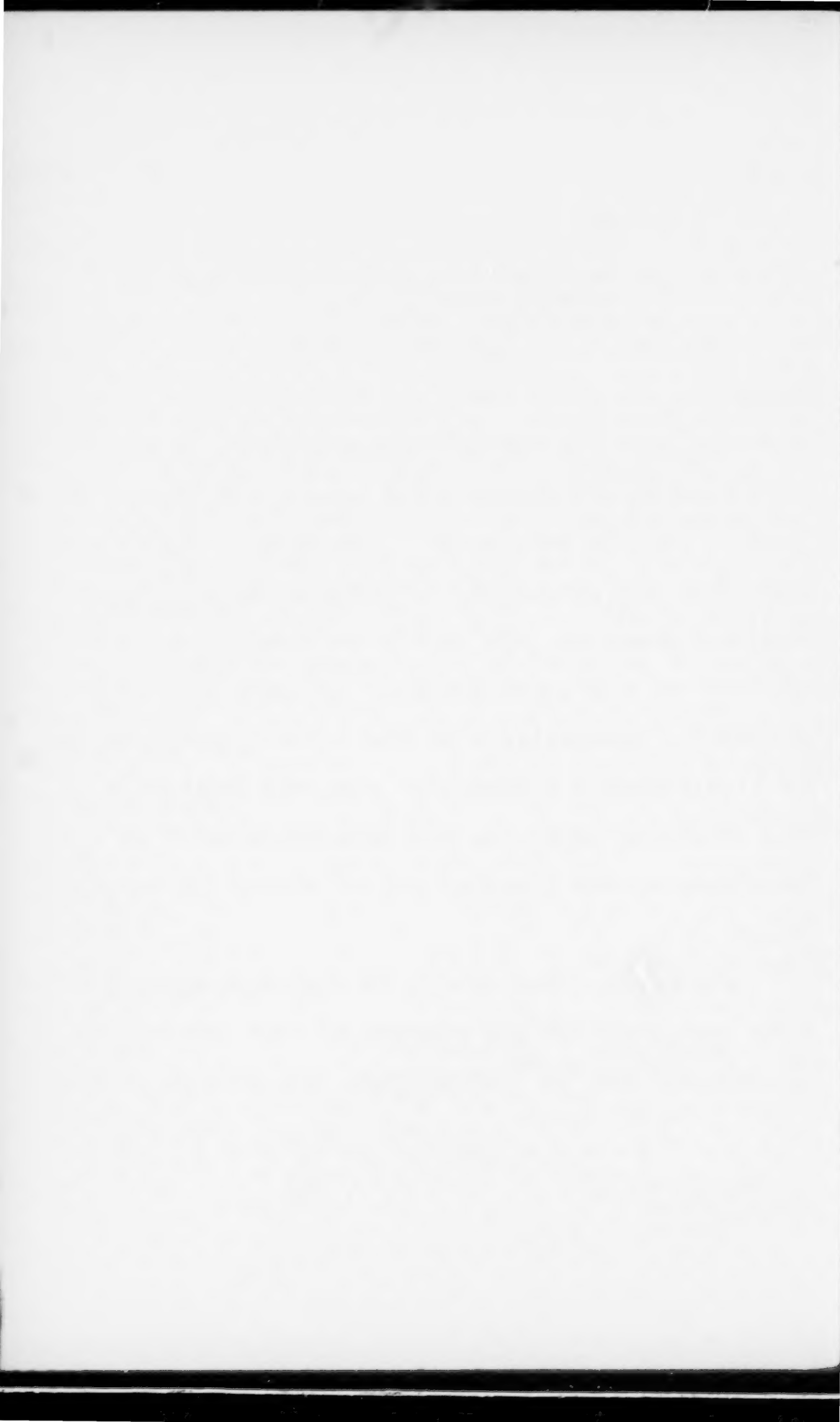
The public nature of the uses is not really in dispute. The only dispute is whether the experimental use doctrine referred to in Elizabeth v. Pavement Co., 97 U.S. 126, 24 L. Ed. 1000 (1877), and interpreted through the years in a multitude of other cases, does in fact apply to the fact situation found by the District Court, whether the burden of proof holding affects that determination, whether the holding as to burden of proof made by the Court of Appeals for the Federal Circuit was correct, and whether the Court of Appeals should have altered the fact findings or should have remanded to the trier of fact.



2. The Court of Appeals altered the fact findings of the District Court without due regard for Rule 52(a).

The Court of Appeals, rather than simply accepting the facts found by the District Court and applying the law to them, proceeded to analyze only some of the evidence for itself, beginning at page 4 of its decision. However, so far as the testimony was concerned, it had access only to the transcripts, not to the live testimony of the witnesses and particularly of the inventor himself. Its analysis of the patient-record cards is significantly different from the analysis of the District Court who did have the benefit of the testimony of the inventor and of other orthodontists.

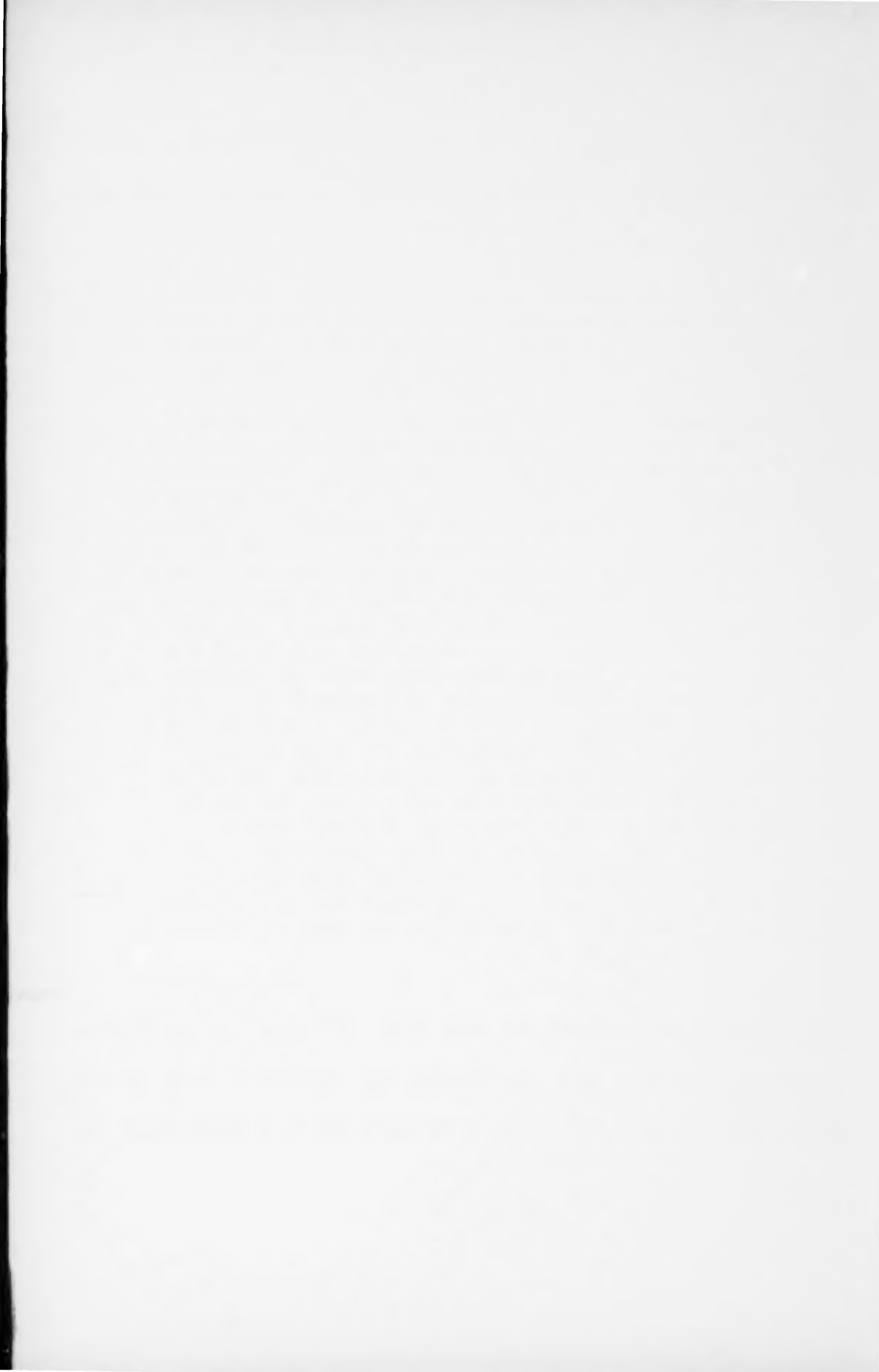
Moreover, the Court of Appeals appears to have lost sight of the purpose of the invention. In column one of the patent, the purpose of the



improvement of this invention is stated as follows (Appendix page 3):

Positive means is provided to effect proper placement of the appliance within the mouth. (Lines 30-32) Means are associated with the resilient appliance to effect proper mating engagement between the appliance and the teeth when the appliance is positioned within the mouth. (Patent column 1, lines 39-42). Positioning elements in the form of C-shaped clips are carried by the appliance for effecting temporary coupling between the appliance and the teeth by engagement in the embrasure areas of the teeth. (Patent, column 1, lines 46-49). Means are provided to assist and assure the proper placement of the appliance in the mouth, including C-shaped clips embedded in the rubber body and adapted to engage in the embrasure areas of the teeth. (Patent, column 1, lines 62-66). Means is provided on the appliance to assure proper seating of the teeth in the respective sockets in the appliance. (Patent, column 2, lines 1-3).

The remainder of the body of the tooth positioning appliance is made in accordance with expired Patent 2,531,222 and is not modified in



any way other than to include a C-shaped clasp (Appendix page 2, Fig. 7). Since the inventor testified and all parties agree that there were no modifications, either tried or adopted, that affected the showing in Figure 7 of the patent during the alleged experimentation, the only question that could have been the subject of experimentation is whether the device of Figure 7 that was tested achieved the stated objectives of the patent, as just quoted. It is important to note that all of the functions and objectives of the C-shaped clip related to positioning the appliance properly as it is placed in the mouth. The inventor himself testified that you could tell when the appliance was placed in the mouth, that those objectives were achieved.

The Court of Appeals for the Federal Circuit appeared to believe that what was being tested was the effectiveness of orthodontic treatment using



the appliance, but that had been established decades before when TP Laboratories began making and using the device of Patent 2,531,222 and others. That device was held to be unpatentable over the prior art in an earlier suit between the parties. TP Laboratories and its predecessor had been making such orthodontic appliances at least since 1953 under the guidance of Dr. Harold Kesling and it was not the subject of the experimentation at issue in this case.

Thus, the object of the experiments was simply to determine whether embedding a C-shaped clip in a known rubber orthodontic appliance would help it to go into place and stay in place. Once in place, it had been known for decades that it would do its job. It was also known that some patients cooperated better than others and got better results than others during orthodontic treatment and the specific outcome of specific



patient treatments was not the point of the experiment either. All of these things were thoroughly brought out in the testimony at the District Court level. The inventor, himself, testified that you could tell immediately with your hands as you placed the device whether the clip was going into place and holding. This is understandable since it had a tendency to snap into place as it passed the curve of the tooth. Even though the clip was substantially rigid, the tooth surface is curved and the resilient tension on the rubber body of the tooth positioner tends to pull the clip into the curve. In testifying about the appliance made for Nancy Furst, Dr. H. Kesling indicated that he knew right away that it was going into place.

Apparently, the Appellate Court was misled because it had not heard the entire trial and possibly overlooked the recitations (quoted above)

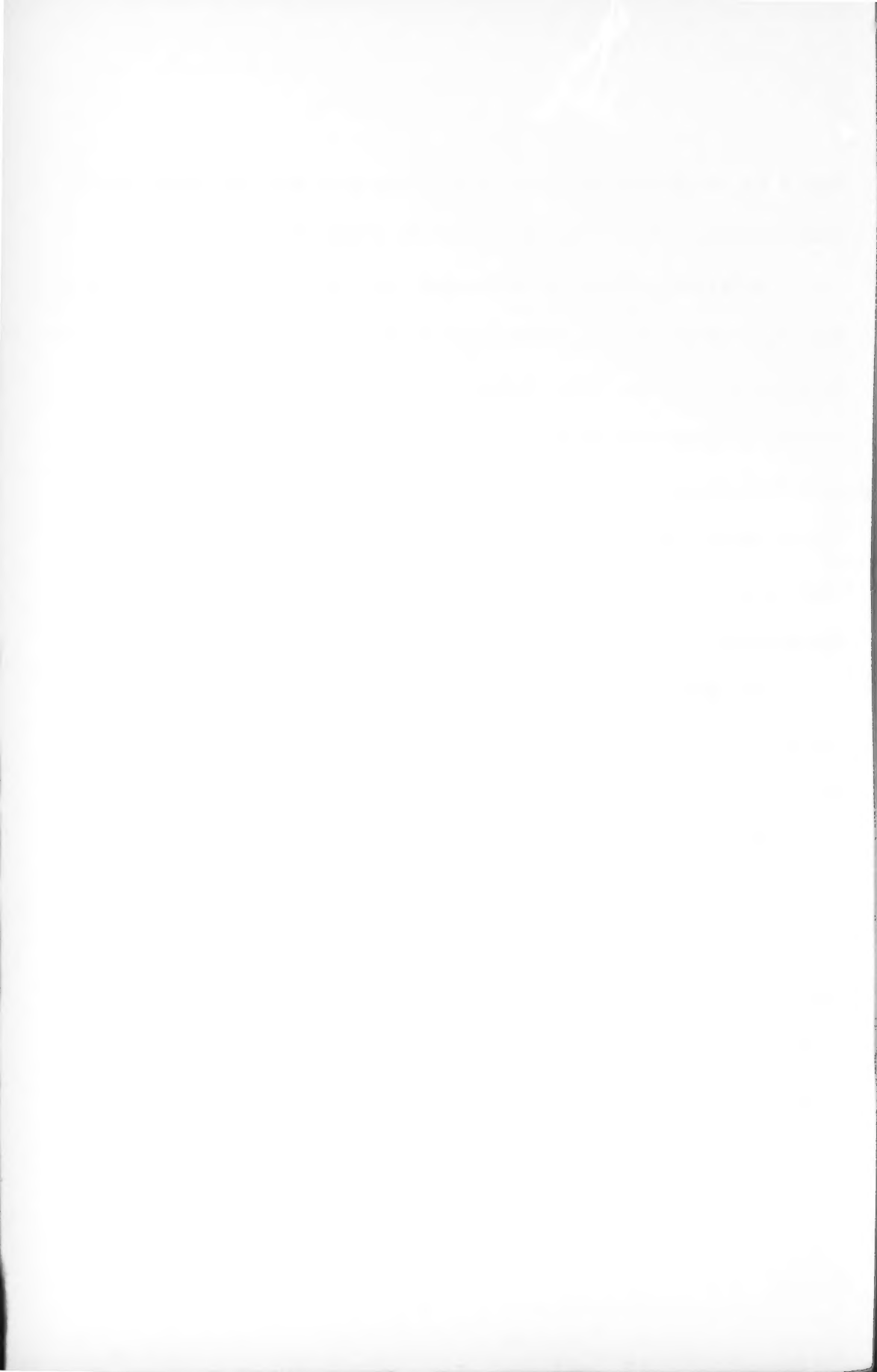


in the introduction to the patent in the suit, indicating that the appliance itself was old.

Against that background of facts established by agreement of the parties and by trial to the District Court, the Appellate Court used a somewhat different analysis that emphasized successful orthodontic treatment, although there was no testimony anywhere in the case that the success or failure of the orthodontic treatment as a whole depended on the clip of the patent in suit.

It was against that background that it evaluated the burden of proof and the burden of persuasion.

The Court of Appeals held, properly, that the burden of proof is on the defendant to prove prior public use under 35 U.S.C. § 102(b). Here the Exhibits, the testimony of the patients, and the testimony of the inventor himself established beyond a shadow of doubt that uses of the patented



invention took place in public. That brought the court directly to the Elizabeth v. Pavement, (supra) dilemma. Do we allow an exception to the statutory bar for public use earlier than allowed by the statute or do we allow the inventor to get by with such use on the ground that he should be afforded a reasonable opportunity for experiment? In Elizabeth v. Pavement, unlike the present case, it was essential that any experiment be public because the invention was a pavement. In the present case, it relates to a removable orthodontic appliance intended for use primarily at night but often recommended for a few hours during the day as well. It did not have to be worn continuously or in public places.

The District Court held on the undisputed evidence that there was no injunction of secrecy or silence imposed on the users. All of the orthodontists at Kesling and Rocke were asked whether



they imposed such conditions and each with the exception of Dr. Harold Kesling, said they did not. Dr. Harold Kesling said that he "thought" that they understood that there was a requirement for secrecy, but even when pressed, refused to testify that he had specifically told them that there was such a requirement. There were three depositions, two of patients, and in one case the father of a patient (Dr. Furst, Susan Spiers Elliot, and Sheila Rumely Brady). Dr. Furst was with his daughter Nancy when she received the tooth positioner with the clip of Figure 7 of the patent. The other two were themselves patients. None remembered being asked to keep the device in any way secret, confidential, or any other precaution having to do with disclosure. At least Susan Elliot testified that she deliberately showed it to her friends. There was definitely public, non-secret use.



3. The patent is invalid even if the burden of proof was on defendant as to experimental use.

Even if the burden of proof rested on defendant to prove the absence of experimental use in order to support the case of public use under § 102(b), that burden of proof was met as shown above. The analysis of the Court of Appeals for the Federal Circuit rested on facts not found by the District Court and on an analysis that missed the mark of the claimed invention of the patent without even specifically considering the fact that it was deviating from the finding of fact of the District Court. Defendant did meet its burden of proof. Defendant proved from the inventor's own lips that there were no experiments in fact.

The District Court found on the basis of that testimony that there was no experiment in fact, at least after the treatment of Nancy Furst.



If the burden of proof was on defendant rather than plaintiff with regard to experimental use, the proper procedure for the Court of Appeals for the Federal Circuit was to remand to the District Court for a new determination based on all of the evidence in the case, including the witnesses heard by the District Court and not by the Court of Appeals. The Court of Appeals was not in an equally good position with the District Court to determine the facts and should not have done so. The case should have been remanded if changing the burden of proof affected the outcome.

4. The Court is requested to grant certiorari.

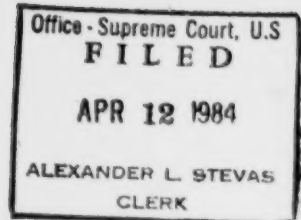
Petitioner submits that only the Supreme Court can restore the settled course of the law that properly requires the inventor to carry the burden of showing that 35 U.S. Code 102(b) should not bar his patent, once it has been shown by



clear and convincing evidence that a use or sale occurred more than a year before the filing of his patent application. Either the District Court decision should be restored or the case should be remanded to it for findings. Certiorari should be granted.

Allan B. Wheeler
606 W. Wisconsin Avenue
Milwaukee, Wisconsin 53203
414-271-1318
414-278-7733

88-1989



Case No.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1983

PROFESSIONAL POSITIONERS, INC.
A WISCONSIN CORPORATION
PROFESSIONAL POSITIONERS, INC.
A DELAWARE CORPORATION
GERALD W. HUGE
RICHARD W. ALLESEE

PETITIONERS-DEFENDANTS,

VS.

T.P. LABORATORIES, INC.
AN INDIANA CORPORATION

RESPONDENT-PLAINTIFF.

ON APPEAL FROM
THE COURT OF
APPEALS FOR
THE FEDERAL
CIRCUIT APPEAL
83-660 CROSS
APPEAL 83-680

APPENDIX A TO PETITION FOR WRIT OF CERTIORARI

ALLAN B. WHEELER
606 W. WISCONSIN AVE.
MILWAUKEE, WIS. 53203
414-271-1318
414-278-7733

ATTORNEY FOR DEFENDANTS

EDITOR'S NOTE

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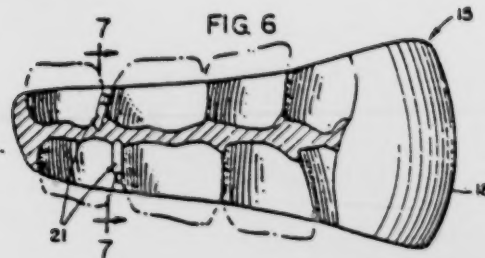
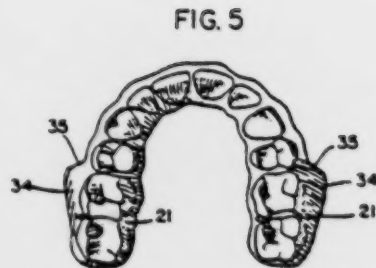
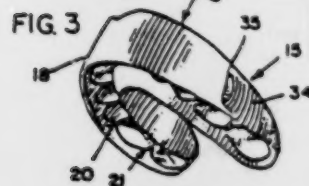
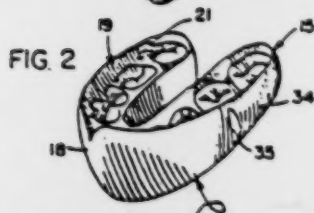
H. D. KESLING

3,178,820

INTRA-ORAL TOOTH POSITIONER

Filed Feb. 19, 1962

2 Sheets-Sheet 1



INVENTOR:
HAROLD D. KESLING

BY
Margaret Johnston, Esq.

ATT'Y'S

Exhibit A

April 20, 1965

H. D. KESLING
INTRA-ORAL TOOTH POSITIONER

3,178,820

Filed Feb. 19, 1962

2 Sheets-Sheet 2

FIG. 7

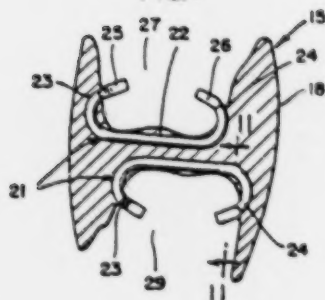


FIG. 8

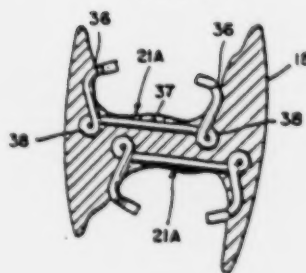


FIG. 9

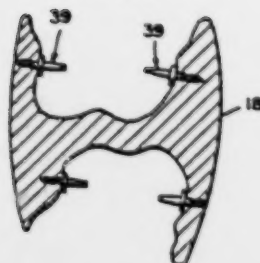


FIG. 10

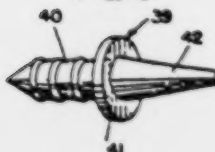
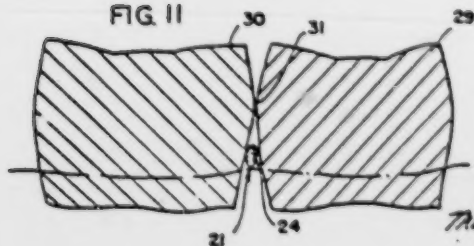


FIG. 11



INVENTOR
HAROLD D. KESLING

BY
Margall, Johnston, Cook & Root

ATT'YS

1

3,178,820

INTRA-ORAL TOOTH POSITIONER

Harold D. Kesling, R.R. 2, La Porte, Ind.

Filed Feb. 19, 1962, Ser. No. 174,174

9 Claims. (Cl. 32-14)

This invention relates in general to dental appliances, and more particularly to a resilient dental appliance worn in the mouth of a person and having means to assure proper fit and orientation of the appliance relative to the teeth. Still more particularly, the present invention relates to a tooth positioning dental appliance capable of urging teeth into preselected positions, such as shown in my Patent No. 2,531,222, wherein means is provided for the appliance to aid in the proper placement of the appliance in the mouth thereby obtaining the most effective usage of the appliance.

Some difficulty has been encountered in the usage of dental appliances worn in the mouth, and especially the tooth positioning appliance of the aforementioned patent, wherein the appliance in certain cases is difficult to properly position and seat against the teeth. For example, the tooth positioning appliance of the aforementioned patent is prepared to urge certain teeth into preselected positions, thereby necessitating elongation and/or stretching of the appliance when placing it in the mouth in order to effect proper seating of the appliance against the teeth. And unless the appliance is properly placed within the mouth, the usefulness is materially, if not completely impaired.

The above problem is overcome by the present invention, wherein positive means is provided to effect proper placement of the appliance within the mouth.

Accordingly, it is an object of the present invention to obviate the above mentioned difficulties and provide an improved dental appliance.

A further object of this invention is to provide a dental appliance having a resilient body with at least the impression therein of the upper or lower teeth, and wherein means are associated with the resilient appliance to effect proper mating engagement between the appliance and the teeth when the appliance is positioned within the mouth.

A still further object of the present invention resides in the provision of a resilient dental appliance having an impression of at least the upper or lower teeth of a person, and wherein positioning elements in the form of C-shaped clips are carried by the appliance for effecting temporary coupling between the appliance and the teeth by engagement in the embrasure areas of the teeth.

A further object of this invention is to provide a dental appliance capable of effecting tooth positioning movements of teeth and including a rubber body having the impression of at least the upper or lower teeth of a person, and wherein means is provided to aid in the proper placement of the appliance in the mouth of a person including pins secured to the rubber body and adapted to engage in embrasure areas of the teeth.

A still further object of this invention is in the provision of a tooth positioning appliance having a body of rubber with at least the impression of the upper or lower teeth formed therein in such a manner as to urge certain teeth into preselected positions, and wherein means are provided to assist and assure the proper placement of the appliance in the mouth including C-shaped clips embedded in the rubber body and adapted to engage in the embrasure areas of the teeth and finger engaging portions formed on the appliance.

A still further object of this invention is to provide a tooth positioning appliance including a body of arch-shaped rubber with teeth sockets formed therein corresponding to the upper and/or lower teeth of a person,

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and wherein means is provided on the appliance to assure proper seating of the teeth in their respective sockets in the appliance.

Other objects, features and advantages of the invention will be apparent from the following detailed disclosure, taken in conjunction with the accompanying sheets of drawings, wherein the reference numerals refer to like parts, in which:

FIG. 1 is a perspective view of a model of teeth from the upper arch which represents the upper teeth in a person;

FIG. 2 is a top perspective view of a dental appliance constructed in accordance with the invention and illustrating the impression for the upper arch;

FIG. 3 is a bottom perspective view of the dental appliance of FIG. 2 and illustrating the impression of the lower arch;

FIG. 4 is a perspective view of a model of the teeth from the lower arch of a person which would be received in the impression in the dental appliance as shown in FIG. 3;

FIG. 5 is a bottom plan view of the dental appliance according to the present invention;

FIG. 6 is a side elevational view of a dental appliance of the present invention, with some parts broken away to show certain parts in section and other parts shown in phantom;

FIG. 7 is a transverse sectional view taken substantially along line 7-7 of FIG. 6 and illustrating one form of positioning means or clip employed for obtaining proper positioning of the dental appliance in a person's mouth, and showing teeth in phantom view;

FIG. 8 is a transverse sectional view similar to FIG. 7, but showing a modified form of a positioning means or clip;

FIG. 9 is a transverse sectional view similar to FIGS. 7 and 8, but showing still another modified form of positioning means wherein pins are provided;

FIG. 10 is an enlarged perspective view of one of the pins used in the embodiment of FIG. 9 wherein it is removed from the appliance; and

FIG. 11 is an enlarged transverse sectional view taken substantially along line 11-11 of FIG. 7.

Referring now to the drawings, and more particularly to FIGS. 1-4, a dental appliance, constructed in accordance with the present invention and generally indicated by the numeral 15 is adapted to be worn by a person in engagement with the upper and lower teeth as illustrated by the models of upper and lower arches generally indicated by the numerals 16 and 17. The dental appliance 15 includes a resilient body 18, preferably of rubber, although any other suitable material may be employed, having an impression 19 for the teeth of the upper arch and an impression 20 for the teeth of the lower arch. The body is generally arch-shaped. Moreover, the impression 19 serves to receive the upper teeth of the model 16, while the impression 20 serves to receive the lower teeth of the model 17. While the dental appliance 15 is shown with impressions for the upper and lower teeth of a person and for all of the teeth on the upper and lower arches, it should be appreciated that a dental appliance could be constructed which would only have an impression for either the upper teeth or the lower teeth, or a portion of the upper or lower teeth, or any combination thereof. Moreover, the dental appliance of the present invention may serve as a conventional mouthpiece for protection of the teeth during athletic events and the like or it may constitute a tooth positioner such as that disclosed in the aforementioned patent, wherein the tooth sockets and the impressions on the appliance are arranged to urge certain teeth into preselected positions. In either event, the dental appliance of the present invention includes means

for facilitating the proper mounting of a dental appliance in the mouth of a person.

The means for properly positioning the dental appliance in the mouth of a person and assuring the proper mating relationship between the teeth and the impressions includes in the embodiment of FIG. 7 positioning or orienting elements in the form of C-shaped clips generally designated by the numeral 21, as seen in FIG. 7. Each clip 21 includes an elongated buccolingual extending base portion 22 and opposed upstanding gingival extending arms 23, 24. The base portion 22 as well as a portion of the arms 23 and 24 are generally embedded in the body 18 to secure them to the body. However, any other suitable way of securing the clips to the body may be employed. The arms 23 and 24 are arcuate in shape and terminate in pointed and tapered ends 25 and 26, respectively, although it should be appreciated that the ends may be blunt if so desired.

Preferably, one C-shaped clip 21 is provided for each quadrant of the mouth, and in the dental appliance 15 as shown there would be four C-shaped clips, one for each of the upper and lower arches on each side of the mouth. If a lesser number of clips is deemed suitable, some of the clips may be omitted. And in situations where there would only be an impression in the appliance of either the upper or lower arches, a lesser number of clips would be employed. As seen in FIG. 7, the pointed ends 25 and 26 substantially face each other and project buccally and lingually, and are arranged to be received in the embrasure areas of the teeth.

Preferably, the clips are arranged on the dental appliance as illustrated in FIGS. 2, 3, 5 and 6 so that they engage in the embrasure areas between the first and second molars, although it should be appreciated that the clips may be arranged in any suitable position to engage in any of the embrasure areas. The first and second molars are indicated respectively by the numerals 27 and 28 in the upper arch and by the numerals 29 and 30 in the lower arch. The embrasure or embrasure area is defined as that space radiating out from the contact point between adjacent teeth, the gingival embrasure or embrasure area being the space situated below the height of contour line, and the occlusal embrasure or embrasure area being the space situated above the height of contour line. First the gingival embrasure area is illustrated in FIG. 11 as the area between the contact point 31 of the molars 29 and 30 and in which area is generally received the inwardly projecting ends 25 and 26 of the arms 23 and 24 of the clips 21.

Placement of the dental appliance 15 in the mouth of a person thusly requires the initial positioning of the C-shaped clips in alignment between the first and second molars after which the clips may be urged toward the gingival embrasure by applying pressure toward the teeth until the ends of the clips enter into the embrasure areas. At that time, it is known that the dental appliance is properly positioned. In a situation where a dental appliance constitutes a tooth positioning appliance for the final straightening of the teeth, and the teeth in the mouth are not in alignment with the sockets in the impressions of the appliance when the positioning appliance is in the mouth, it is sometimes necessary to stretch and/or elongate the appliance in order to obtain the proper seating of the teeth in the sockets of the impressions. Where no clips are provided, oftentimes the sockets are not properly seated and therefore, the tooth positioning appliance gives little benefit to the final straightening process of the teeth. Thus, with the clips, the person wearing the tooth positioning appliance can be assured of proper fitting and placement of the appliance within the mouth and thereafter receive greater benefit from the positioning appliance when worn.

To further assist in placement of a dental appliance in the mouth, enlarged portions or buttons 34 are formed on the buccal surface of the appliance and at the distal

ends thereof to define shoulders 35. The shoulders 35 are adapted to receive the fingers of the person desiring to position the appliance in the mouth such as the ends of the first finger and thumb of a person in order to provide an area wherein the appliance may be gripped for elongation thereof in the final placement of the appliance in the mouth. However, the enlarged portions 34 are not sized so that they would cause any discomfort within the mouth.

The clips 21 may be made of any suitable material such as metal or plastic in wire or ribbon form. Actually the cross section of the clips may be of any desirable shape as long as the ends are formed so that they will fit in the embrasure areas between the teeth. Preferably, the clips are made so that they are quite rigid or stiff.

Referring now to FIG. 8, a modification of the invention is illustrated wherein C-shaped clips 21A are shown which differ somewhat from the C-shaped clips 21 of FIG. 7 in that the upstanding arms 36 are connected to the buccal-lingually extending base portion 37 by means of spring loops 38. The spring loops 38 serve to define a resiliency between the arms 36 and the base portion 37, and the loops along with the base portion and a portion of the arms are embedded in the rubber body 18. Otherwise, the C-shaped clips 21A operate in the same manner as the C-shaped clips 21.

Another embodiment is shown in FIGS. 9 and 10, wherein the C-shaped clips of the embodiments of FIGS. 7 and 8 are replaced by sets of pins 39. Each pin 39 includes a serrated tail or anchoring portion 40 adapted to be embedded in the rubber body 18, a positioning flange 41 arranged to abut against the buccal and lingual facing surfaces of each impression, and a conical or pointed end 42 adapted to engage in the embrasure areas between the teeth. It should be appreciated that the pins 39 may take any suitable form, but in this case are individually mounted in the body of the appliance, preferably in pairs as shown in FIG. 9 so as to engage from opposite sides of the impression in the embrasure areas between teeth. The pins 39 may be made of metal, plastic or any other suitable material, and it should be appreciated that in some instances only a single pin may be used in one quadrant. In other words, a pair of pins 39 need not be used in cooperation with each other in order to provide the necessary positioning function for the present invention. Placement of an appliance having the pins would be similar to that of the embodiments of FIGS. 7 and 8.

It will be understood that modifications and variations may be effected without departing from the scope of the novel concepts of the present invention, but it is understood that this application is to be limited only by the scope of the appended claims.

The invention is hereby claimed as follows:

1. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means having at least one terminal extremity projecting from said impression side walls to thereby engage in an embrasure area of the teeth of a wearer and orient the appliance in the mouth.

2. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means having a plurality of terminal extremities projecting from said impression side walls to thereby engage

in embrasure areas of the teeth of a wearer and orient the appliance in the mouth.

3. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means having at least a pair of opposed terminal extremities projecting from said impression side walls to thereby engage in embrasure areas of the teeth of a wearer and orient the appliance in the mouth.

4. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and substantially rigid means supported by said body including a pair of opposed pins anchored in said body having terminal extremities projecting from said impression side walls to thereby engage in embrasure areas of the teeth of a wearer and orient the appliance in the mouth.

5. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means including a substantially C-shaped member having opposed terminal extremities projecting from said impression side walls to thereby engage in embrasure areas of the teeth of a wearer and orient the appliance in the mouth.

6. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means including a substantially C-shaped member having a bight portion embedded in the body below the bottom of the impressions and opposed terminal ends extending directly from the bight portion and projecting from said impression side walls toward one another to thereby engage in embrasure areas of the teeth of a wearer and orient the appliance in the mouth.

7. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means including a pair of opposed terminal extremities resiliently urged toward one another to thereby engage in embrasure areas of the teeth of a wearer and orient the appliance in the mouth.

8. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means including a substantially C-shaped member having a bight portion embedded in the body below the bottom of the impressions and opposed terminal ends extending from the bight portion and projecting from said impression side walls toward one another to thereby engage in embrasure areas of the teeth of a wearer and orient the appliance in the mouth, and loop portions between said bight portion and said terminal extremities causing said extremities to be resiliently urged toward one another.

9. A dental appliance comprising a molded arch-shaped body of resilient material, said body being formed to fit within the mouth of a person between the upper and lower arches, said body including impressions of the teeth of at least one of the arches, said impressions having a bottom and opposite side walls, and at least one substantially rigid means supported by said body, said means having at least one terminal extremity projecting from said impression side walls to thereby engage in an embrasure area of the teeth of a wearer and orient the appliance in the mouth, and finger engaging shoulders on the body for facilitating the mounting of the appliance on the teeth.

References Cited by the Examiner

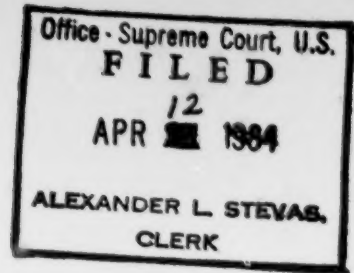
UNITED STATES PATENTS

2,678,043	3/54	Stark	128-136
2,705,006	3/55	Cettel et al.	128-136

RICHARD A. GAUDET, *Primary Examiner*.

ROBERT E. MORGAN, *Examiner*.

(3) 88-1939



Case No.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1983

PROFESSIONAL POSITIONERS, INC.
A WISCONSIN CORPORATION
PROFESSIONAL POSITIONERS, INC.
A DELAWARE CORPORATION
GERALD W. HUGE
RICHARD W. ALLESEE

PETITIONERS-DEFENDANTS,

VS.

T.P. LABORATORIES, INC.
AN INDIANA CORPORATION

RESPONDENT-PLAINTIFF.

ON APPEAL FROM
THE COURT OF
APPEALS FOR
THE FEDERAL
CIRCUIT APPEAL
83-660 CROSS
APPEAL 83-680

APPENDIX B TO PETITION FOR WRIT OF CERTIORARI

ALLAN B. WHEELER
606 W. WISCONSIN AVE.
MILWAUKEE, WIS. 53203
414-271-1318
414-278-7733

ATTORNEY FOR DEFENDANTS

84 pp



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Court of Appeals, Federal Circuit

TP Laboratories, Inc. v.
Professional Positioners, Inc. et al.

Nos. 83-660 and 83-680

Decided Jan. 4, 1984

Consolidated appeals from District Court
for Eastern District of Wisconsin, Warren J.

Action by TP Laboratories, Inc., against
Professional Positioners, Inc. (Wisconsin),
Professional Positioners, Inc. (Delaware),
Gerald W. Huge, and Richard W. Allesse, for
patent infringement. From judgment for defen-
dant in part, both parties appeal. Affirmed
in part, reversed in part and remanded.

Lloyd L. Zickert, Chicago, Ill. (Glenn
W. Ohlson, Chicago, Ill., on the brief), for
plaintiff.

Allan B. Wheeler, Milwaukee, Wis., for
defendants.

Before Markey, Chief Judge, Skelton,
Senior Circuit Judge, and Nies, Circuit Judge.

Nies, Circuit Judge.

These appeals are from the October 27, 1982 judgment of the United States District Court for the Eastern District of Wisconsin (Warren, J.) dismissing a charge of infringement of a patent for an orthodontic appliance. Sitting without a jury, the court held U.S. Patent No. 3,178,820 ('820), owned by TP Laboratories, Inc. (TP), invalid under 35 U.S.C. § 102(b), on the ground that a public use occurred more than one year prior to the filing date of the application for the subject patent.

TP appeals the holding of invalidity. TP admits that the inventor used the dental appliance on three orthodontal patients during the critical period but asserts that such use

was non-barring experimental use. On this issue we agree with appellant and reverse. However, since the issue of whether the accused devices are infringements, as well as other issues, were not decided, it is necessary to remand.

In the cross-appeal Professional Positioners et al. (PRO) appeal the denial of an award of attorney fees under 35 U.S.C. § 285, and seek an increase in the amount awarded under Rule 37(d) of the Fed. R. Civ. P. for costs attributable to TP's late production of certain documents during discovery. We affirm the district court's decisions on these matters.

Our jurisdiction is found in 28 U.S.C. § 1295(a)(1).

I

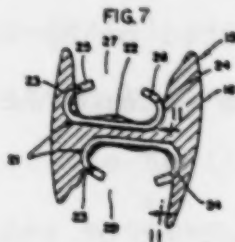
Appellant-plaintiff, TP Laboratories, Inc., makes and sells orthodontic supplies and appliances to the dental profession. TP Laboratories is a separate business from the professional practice of the Kesling and Rocke Orthodontic Group (K&R), a group of four orthodontists, Doctors Harold D. Kesling, Robert A. Rocke, Peter C. Kesling and David I. Kesling, but the firms are closely connected. The record before us shows that Dr. Harold Kesling, now deceased, (Kesling), who is the inventor named in the patent in suit, was an officer and one of the owners of TP Laboratories. Dr. Peter Kesling is president. The two businesses share a small building and employ the same office manager.

Kesling conceived and made the first proto-type of the invention of the patent in suit in 1956. It was not, however, until

February 19, 1962, that Kesling filed a patent application on his invention for which the '820 patent was granted on April 20, 1965. On November 1, 1965, the patent was assigned to TP Laboratories.

The subject matter of the '820 patent is a molded tooth positioning appliance which is to be worn several hours a day by a person undergoing orthodontal treatment. The general type of device is not new. The improvement by Kesling lies in placing wires in the device which fit in the embrasure area between the teeth and keep the appliance in position without the necessity of the patient exerting constant jaw pressure. The wires are referred to as "seating devices," "seating springs," "precision seating springs," "springs," or "metal adjuncts." Because of the shape, as

seen below, the invention is also referred to as a tooth positioner with "C's":



This figure is a transverse sectional view illustrating one form of positioning means or clip employed for obtaining proper positioning of the dental appliance in a person's mouth.

The use of tooth positioners with C's in the treatment of three K&R patients during the period 1958-61 led to the issues under 35 U.S.C. § 102(b). It is undisputed that these three devices fell within the language of the '820 claims and no modification of design was made as a consequence of these uses. The evidence which established these uses was found in the patient records of K&R and the underlying facts are not in dispute. Appel-

lant characterizes these uses as secret and/or experimental; appellees urge that they are, as found by the district court, public uses within the meaning of the statute.

The first use of the claimed invention on a patient occurred on August 25, 1958. Orthodontal treatment of this patient (Furst) spanned the time period between February 1958 and April 1964. Use of the device terminated after approximately two months. During discovery, the device itself was produced, having been retained by K&R in the patient's model box. This patient's mandibular model from the model box was inscribed "experimental wires." Over the six year period of treatment, this patient was also fitted with other devices, retainers as well as positioners not embraced by the '820 claims.

Another patient (Rumley-Brady) who had begun treatment in August 1958 was supplied

with a tooth positioner equipped with C's on November 10, 1959. Entry on the record card of this patient indicates "results fair" on December 18, 1959; "results better" on February 5, 1960, and "results good" on August 1, 1960. Nevertheless, use of the device was discontinued on January 16, 1961, in favor of retainers, because certain spacing irregularities were not being corrected. The same positioner with C's was again prescribed on May 5, 1961, and was used in conjunction with various other devices until at least March of 1962. The patient missed a later scheduled appointment which is the last entry on her card.

A positioner with C's was prescribed for a third patient (Spiers-Elliott) on November 1, 1960. Its use apparently was discontinued about three months later, a different device

being mailed to the patient on February 2, 1961. During the treatment of this patient, which spanned the period of time between January 21, 1960, and November 24, 1961, three different positioners were prescribed, only one of which was embraced by the '820 claims.

The initial use in each of the above cases occurred prior to the critical date of February 19, 1961. During the years 1958-60, K&R placed 606 tooth positioners, of which only the three described above were within the claims of '820. In 1961, after the critical date, 28 tooth positioners with C's were prescribed by K&R out of a total of 151.

The above devices were made for the K&R patients by TP, including C's handmade by Kesling. There is no evidence that K&R charged patents [sic] specifically for any positioner. With two of the three patients,

K&R followed its regular practice of setting a fixed total fee for professional services, which included necessary appliances. One patient (Furst), whose father was a dentist, received free treatment as a professional courtesy.

Sales of the patented device to other orthodontists began in 1966, that is, only after TP's acquisition of the patent. Appellees, Hugu and Allessee, had no knowledge of the invention even though employed at TP prior to 1961.

The district court did not rule on whether appellees' allegedly infringing devices came within the scope of the claims of the '820 patent and we know only that infringement is charged since 1972.

[2] More specifically, courts have discerned a number of factors which must be weighed in applying the statutory bar of § 102(b).² Operating against the inventor are the policies of 1) protecting the public in its use of the invention where such use began prior to the filing of the application, 2) encouraging prompt disclosure of new and useful information, 3) discouraging attempts to extend the length of the period of protection by not allowing the inventor to reap the benefits for more than one year prior to the filing of the application. In contrast to these considerations, the public interest is also deemed to be served by allowing an inventor time to perfect his invention, by public testing, if desired, and prepare a patent application.

II

A

The patent statute provides in pertinent part in 35 U.S.C. § 102:

A person shall be entitled to a patent unless -

* * *

(b) the invention was . . . in public use . . . in this country, more than one year prior to the date of the application for patent in the United States.

Decisions under this provision and comparable provisions in earlier statutes are marked by confusion and inconsistency.¹

[1] "The general purpose behind all the [102(b)] bars is to require inventors to assert with due diligence their right to a patent through the prompt filing . . . of a patent application." 2 D. Chisum, Patents § 601 (1981 & Supp. 1983).

The district court's consideration of the issue of public use proceeded according [sic] to the following two-step analysis:

Consequently, the first step in analyzing Pro's 35 U.S.C. § 102(b) assertion is to determine whether a public use occurred. If a public use is found, then the Court must ascertain whether the use was not a public use under the statute because it was experimental.

As to the first step, the district court reasoned:

The evidence in this case clearly establishes use by at least three patients more than one year prior to the application date. Furthermore, these users were "under no limitation, restriction or obligation of secrecy to the inventor." *Randolph v. Allis-Chalmers Manufacturing Co.*, 264 F.2d at 535 [120 USPQ at 513]. Certainly there is no evidence to the contrary and there is testimony to support such a finding Consequently, the Court can only conclude that the patients were under no obligations of secrecy or for that matter any restrictions.

TP argues that these items were in secret because even the patients were not aware of the "testing." this is not significant. The plain fact is that the claimed invention was not kept secret. It was open to public observation without restriction which is sufficient to constitute "public use." See *Egbert v. Lippmann*, 104 U.S. 333 (1881). Furthermore, Dr. Furst was aware that the precision seating springs were a new device In addition, several of Mrs. Spiers Elliott's associates saw the device. Consequently, the feigned secrecy relied upon by TP accords it no aid in claiming that the "use" was not "public."

On the second issue as perceived by the district court, the court placed a heavy burden of proof on the patent owner to prove that the inventor's use had been experimental and expressly found that TP did not carry that "burden." In the words of the court:

The inventor bears a heavy burden of showing that the public use was bona fide experimentation.

* * *

The experimental exception is unavailable to plaintiff TP for two reasons. First, the evidence presented does not establish that the patentee was conducting a bona fide experiment. On the contrary, the record shows that the uses were random and poorly monitored. The only records kept by Dr. H. Kesling were the patient records. Dr. H. Kesling, the inventor, did not always evaluate how well the precision seating springs worked when the patients visited the clinic. Other doctors often made evaluations of performance. Furthermore, while the issue of experimentation is in effect a matter of the inventor's intent, in the present case the evidence indicates that his intent was not experimentation. In experimenting on a prior "invention," Dr. H. Kesling kept accurate records of the results of his experiments. In the present case, the records are scanty at best.

It is important to note that the burden was on the plaintiff TP to show that use was a genuine experiment. Accurate records of the results of an experiment are certainly an indicia that the use was a bona fide experiment. In contrast the dearth of such records indicate that the use was not an experiment. The experimental use exception "is to be guarded closely." *Atlas Chemical Industries, Inc. v. Moraine*

Products, [509 F.2d 1, 4] 184 USPQ 281, 283 (6th Cir. 1974). TP has simply failed to prove that the inventor, Dr. H. Kesling, was conducting a bona fide experiment.

Assuming, however, that the use was experimental, the delay in filing the patent application was unreasonable. The first use of the invention was in August of 1958. By April of 1959, Dr. H. Kesling knew that the precision seating sprigs operated as designed Nevertheless, Dr. H. Kesling waited until February 19, 1962 to file his patent application. Significantly, the claimed invention disclosed in figure 7 of the patent in suit is substantially the same as the precision seating spring disclosed in the positioner . . . supplied to Nancy Furst in August of 1958.

* * *

The delay here was unreasonable because the device proved satisfactory immediately. At least as early as 1960 Dr. Kesling learned that the invention was workable. At that point his time began to run under 35 U.S.C. § 102(b). Even if he had made minor improvements over the period, all this Court needs [sic] find is that the application was filed more than one year after the basic invention was disclosed within the meaning of section 102(b).

Franz Manufacturing Co. v. Phenix Manufacturing Co., 457 F.2d 314 [173 USPQ 266] (7th Cir. 1972). This Court is of the opinion that when an experiment tolls section 102(b), the one-year period of limitations commences to run when the invention disclosed proves workable.

We disagree with this analysis and the shift in the burden of proof which led the district court to an erroneous result.

B

It is not public knowledge of his invention that precludes the inventor from obtaining a patent for it, but a public use or sale of it.

[3] The above quotation is from *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126, 136 (1877), which is the starting place for analysis of any case involving experimental use. There, a toll road, built according to the invention of the patent in suit, was in daily use for a period of 6 years before the inventor filed for a patent. In

upholding the validity of the patent, the Supreme Court spoke with clarity but through the years the guidelines set forth therein have been obfuscated. Returning to the original, we quote the following passages which are particularly pertinent to our analysis here:

That the use of the pavement in question was public in one sense cannot be disputed. But can it be said that the invention was in public use? The use of an invention by the inventor himself, or of any other person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded as such a use. Curtis, Patents, sect. 381; Shaw v. Cooper, 7 Pet. 292.

Now, the nature of a street pavement is such that it cannot be experimented upon satisfactorily except on a highway, which is always public.

When the subject of invention is a machine, it may be tested and tried in a building, either with or without closed doors. In either case, such use is not a public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it, or not. His experiments

will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment; and no one would say that such a use, pursued with a bona fide intent of testing the qualities of the machine, would be a public use, within the meaning of the statute. So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent.

It would not be necessary, in such a case, that the machine should be put up and used only in the inventor's own shop or premises. He may have it put up and used in the premises of another, and the use may inure to the benefit of the owner of the establishment. Still, if used under the surveillance of the inventor, and for the purpose of enabling him to test the machine, and ascertain whether it will answer the purpose intended, and make such alterations and improvements as experience demonstrates to be necessary, it will still be a mere experi-

mental use, and not a public use, within the meaning of the statute.

Whilst the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it. If it be a grist-mill, or a carding-machine, customers from the surrounding country may enjoy the use of it by having their grain made into flour, or their wool into rolls, and still it will not be in public use, within the meaning of the law.

But if the inventor allows his machine to be used by other persons generally, either with or without compensation, or if it is, with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law.

97 U.S. at 134-35.

In the decision on appeal, the trial court looked for proof of an exception to the public use bar. However, in Elizabeth, the Supreme Court did not refer to "experimental use" as an "exception" to the bar otherwise created by a public use. More precisely, the Court reasoned that, if a use is experimental,

even though not secret, "public use" is negated. This difference between "exception" and "negation" is not merely semantic. Under the precedent of this court, the statutory presumption of validity provided in 35 U.S.C. § 282 places the burden of proof upon the party attacking the validity of the patent, and that burden of persuasion does not shift at any time to the patent owner. It is constant and remains throughout the suit on the challenger. As stated in Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 219 USPQ 8, 11-12 (Fed. Cir. 1983):

35 USC 282 permanently places the burden of proving facts necessary to a conclusion of invalidity on the party asserting such invalidity. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Reg. 1983); Solder Removal, supra, 582 F.2d at 633, 199 USPQ at 133.

[4] Under this analysis, it is incorrect to impose on the patent owner, as the trial

court in this case did, the burden of proving that a "public use" was "experimental." These are not two separable issues. It is incorrect to ask "Was it public use?" and then, "Was it experimental?" Rather, the court is faced with a single issue: Was it public use under § 102(b)?

[5,6] Thus, the court should have looked at all of the evidence put forth by both parties and should have decided whether the entirety of the evidence led to the conclusion that there had been "public use." This does not mean, of course, that the challenger has the burden of proving that the use is not experimental. Nor does it mean that the patent owner is relieved of explanation. It means that if a prima facie case is made of public use, the patent owner must be able to point to or must come forward with convincing

evidence to counter that showing.³ See Strong v. General Electric Co., 434 F.2d 1042, 1044, 168 USPQ 8,9 (5th Cir. 1970). The length of the test period is merely a piece of evidence to add to the evidentiary scale. The same is true with respect to whether payment is made for the device, whether a user agreed to use secretly, whether records were kept of progress, whether persons other than the inventor conducted the asserted experiments, how many tests were conducted, how long the testing period was in relationship to tests of other similar devices. In other words, a decision on whether there has been a "public use" can only be made upon consideration of the entire surrounding circumstances.

[7] While various objective indicia may be considered in determining whether the use is experimental, the expression by an inventor

of his subjective intent to experiment, particularly after institution of litigation, is generally of minimal value. In re Smith, 714 F.2d at 1127, 218 USPQ at 976.

C

[8] Applying the principles set forth above to this case, that non-secret uses of the device were made prior to the critical date is not in itself dispositive of the issue of whether activity barring a patent under 35 U.S.C. § 102(b) occurred. Minnesota Mining & Manufacturing Co. v. Johnson & Johnson, 179 USPQ 216, 220 (N.D. Ill 1973). The fact that the device was not hidden from view may make the use not secret but non-secret use is not ipso facto "public use" activity. City of Elizabeth v. American Nicholson Pavement Co., 97 U.S. at 136. Nor, it must be added, is all secret use ipso facto not "public use" within

the meaning of the statute, if the inventor is making commercial use of the invention under circumstances which preserve its secrecy.

[9] Turning to the instant case, we note first that disclosure of the seating device to patients could not be avoided in any testing. In some circumstances, no doubt it would be significant that no pledge of confidentiality was obtained from the user. In the circumstances of use by orthodontal patients, we attach no importance to the fact that the doctor did not ask a patient to swear to secrecy. As in City of Elizabeth, testing of the device had to be public to some extent and it is beyond reasonable probability that a patient would show the device to others who would understand the function of the C's or would want to duplicate the device. One is all that is needed and, if lost or broken, the

patient would expect it to be replaced by the treating dentist.

In any event, a pledge of confidentiality is indicative of the inventor's continued control which here is established inherently by the dentist-patient relationship of the parties. Nothing in the inventor's use of the device on his patients (or the transfer to them) is inconsistent with experimentation. Similarly, the routine checking of patients by one of the other K&R orthodontists does not indicate the inventor's lack of control or abandonment to the public.

Secondly, the finding is clearly erroneous that the invention "proved satisfactory immediately," or "by April of 1959." In this connection, it is noted that the '820 patent itself describes a utility of the patented device for correcting orthodontal irregulari-

ties as "urging teeth into preselected positions." The patient records discussed above indicate that treatment to correct such orthodontal irregularities can range from two to six years. Moreover, while results appeared to be good within six months use by one patient, the variable of patient cooperation cannot be checked by one patient alone. Use on three patients is not an obviously excessive number. In other words, the test for success of the improvement was not whether it could be used at all, but whether it could be said to work better in patients than a positioner without C's. Again, as in City of Elizabeth, the test of necessity had to run for a considerable time and on several patients before the inventor could know whether "it was what he claimed it to be" and would "answer the purpose intended."

[10] A factor in favor of the patentee is that during this critical time the inventor had readily available all of the facilities of TP to commercially exploit the device. Yet, no positioners with C's were offered competing orthodontists despite the fact this was one facet of the inventor's total business activity. Further, the inventor made no extra charge for fitting the three patients with the improved positioners although that in itself is not critical. The facts here indicate the inventor was testing the device, not the market. No commercial exploitation having been made to even a small degree prior to filing the patent application, the underlying policy of prohibiting an extension of the term is clearly not offended in this respect.

Indeed, none of the policies which underlie the public use bar and which, in effect,

define it have been shown to be violated. At most, the record shows that the uses were not secret, but when the evidence as to the facts of use by the inventor is considered as a whole, we conclude that appellees failed to prove that the inventor made a public use of the subject invention within the meaning of 35 U.S.C. § 102(b). The patent may not be held invalid on this ground.

III

Fees Under Rule 37(d) of the Fed. R. Civ. P.

No error or abuse of discretion is found in the award of fees to appellees under Rule 37(d) or in the amount of the award. Appellant's premise that no order of the court was violated by its failing to produce certain invoices ignores the scope of the December 31, 1975 order. In PRO's motion leading to that order "All invoices . . . to Kesling-Rocke

Orthodontic Center" were specifically designated and thus, the withheld invoices fall under its terms.

IV

PRO's cross-appeal from the district court's denial of attorney fees under 35 U.S.C. § 285 is dismissed as moot. In view of our disposition of the appeal, PRO is no longer a prevailing party to whom an award should be made. Stickle v. Heublein, Inc., 716 F.2d 1550, 1564, 219 USPQ 377, 386 (Fed. Cir. 1983).

Summary

The decision of the district court holding U.S. Patent No. 3,178,820 invalid is reversed. The decision of the court awarding costs and fees under Rule 37(d) is affirmed. The cross-appeal is dismissed. The case is

remanded to the district court for proceedings
consistent herewith.

Endnotes

¹Compare *Watson v. Allen*, 254 F.2d 342, 117 USPQ 68 (DC Cir. 1958) with *In re Blaisdell*, 242 F.2d 779, 113 USPQ 289 (CCPA 1957); See G.T. Welch, *Patent Law's Ephemeral Experimental Use Doctrine*, 11 *Tol. L. Rev.* 865-92 (1980); Note, *The Public Use Bar to Patentability; Two New Approaches to the Experimental Use Exception*, 52 *Minn. L. Rev.* 851 (1968); Wells & Riggins, *Public Use and Sale as a Bar to Obtaining a Patent and Its Application to Government Activities*, 18 *Am. U.L. Rev.* 43, 51-57 (1968); Pigott, *The Concepts of Public Use and Sale*, 49 *J. Pat. Off. Soc'y* 399, 411-26 (1967); Comment, *Experimentation and Public Use of Inventions - An Analysis of Appellate Anemia*, U. Ill. L. F. 585 (1960); Vassil, *Public Use; The Inventor's Dilemma*, 36 *Geo. Wash. L. Rev.* 297 (1958).

²See generally, *In re Smith*, 714 F.2d 1127, 1135, 218 USPQ 976, 983 (Fed. Cir. 1983).

³We do not read *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (1887) as contrary to this view, as urged by appellees. However, assuming that in *Smith & Griggs*, the Court intended to impose the ultimate burden of persuasion on the patent holder rather than merely the burden of going forward with countering evidence, we do not believe that view is tenable in the face of the subsequently enacted statutory presumption. As stated in *Austin Machinery Co. v. Buckeye Traction*

Ditcher Co., 13 F.2d 697, 700 (6th Cir. 1926), where a similar argument was advanced with respect to the meaning of Smith & Griggs:

The presumption of the validity of the patent is such that the defense of invention by another must be established by the clearest proof - perhaps beyond reasonable doubt. The same rule apparently should apply to the defense of prior public use or sale by the inventor. When an actual sale in the critical period appears, it may well be that the trier of fact will mentally shift the burden of evidence necessary to show this sale to have been so modified that its existence did not make the device "on sale" within the meaning of the statute; but we see no reason why the legal burden of proof should shift, and we know of no authoritative and considered decision to that effect. It would seem that the legal and heavy burden of proof as to all the elements involved continues until the end upon one who attacks the patent grant.

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WISCONSIN

TP LABORATORIES, INC.

Plaintiff,

vs.

Case No. 72-C-697

PROFESSIONAL POSITIONERS, INC.
a Wisconsin Corporation,
GERALD W. HUGE, and
RICHARD W. ALLESEE,

Defendants.

MEMORANDUM AND ORDER

This is a patent infringement action brought by plaintiff TP Laboratories (TP) against defendant Professional Positioners (Pro) and two of Pro's stockholders, Messrs. Gerald W. Huge and Richard Allesee. TP claims that Pro infringed TP's patent No. 3,178,820 ('820) for a tooth positioning appliance having seating devices. Pro claims that it has not infringed plaintiff's patent and has in

addition filed a counterclaim seeking a declaratory judgment that TP's patent is invalid.

The patent in suit was issued to Dr. Harold D. Kesling on April 20, 1965 on an application filed February 19, 1962 (PX 1). It was later assigned to TP by Dr. H. Kesling on November 1, 1965. A trial was had on the parties' claims and the following constitutes the Court's findings of fact and conclusions of law as required by Rule 52(a) of the Federal Rules of Civil Procedure.

Subsequent to the trial of this matter, the ownership of the stock in defendant Pro changed hands. Therefore, plaintiff moved to add Professional Positioners, Inc., a Delaware corporation, and Bristol Myers Company as party defendants. By stipulation and order, Professional Positioners, Inc., a Delaware corporation, was added as a party defendant.

Nevertheless, TP persists in its efforts to add Bristol Myers. After the substantive issues are resolved, the Court will reach this procedural issue.

Plaintiff TP is an Indiana corporation which manufactures and sells custom made tooth positioning devices to orthodontists. Defendant pro (throughout the substantive portion of this memorandum, Pro refers to the original corporate defendant) is a Wisconsin corporation which manufactures custom orthodontic appliances. Jurisdiction exists pursuant to 28 U.S.C. § 1338(a) and venue properly lies in this district under 28 U.S.C. § 1400(b).

The two individual defendants are stockholders and executives of Pro. Defendant Huge, a resident of Racine, Wisconsin, is the president of Pro, is an original incorporator of Pro, is a director and controlling share-

holder of the defendant corporation, and was the principal designer of the accused infringing device. Defendant Richard W. Allesee is also a Racine resident, is a former officer and general manager of TP, is now a vice president for Pro, is a director and majority stockholder of Pro, and was charged with marketing the accused infringing appliance.

The Harold D. Kesling patent, No. 3,178,820, is directed to an improvement of a tooth positioning appliance ("positioner"). The type of positioner involved in the patent is a flexible, resilient, rubber-like one-piece body which is custom molded to fit the individual patient's teeth. The purpose of such an appliance is to complete the alignment of teeth following orthodontic treatment with conventional appliances. The claimed inven-

tion is an improvement on the positioning and seating of the tooth positioner.

The improved tooth positioning appliance of the invention included a seating device (precision seating springs) made of a material that is substantially rigid relative to the resilient material of the appliance body and which coacts with the body to enhance the seating of the appliance on the teeth of a patient and also to retain the appliance in position on the teeth without the need for constant pressure by the jaws of the patient to maintain the appliance in position. Accordingly, the results achievable by the Kesling invention as disclosed and claimed in the patent in suit are materially increased over the appliance without seating devices. The results achievable by the use of the Kesling invention in conjunction with the positioner

do not require the patient's cooperation as needed with the prior art.

Pro claims that TP is not entitled to the patent in suit because it was "in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . ." 35 U.S.C. § 102(b). Pro asserts that positioners with precision seating springs were supplied to three patients, Nancy Furst, Sheila Rumely Brady, and Susan Spiers Elliot, more than one year before the patent application was filed. It is Pro's contention that providing these patients with positioners utilizing precision seating springs constituted a public use within the meaning of section 102(b). Plaintiff TP counters that, in supplying certain patients with the claimed invention, Dr. Kesling did not make a public use. Plaintiff

TP argues further, however, that, even if use was public, it was not a public use within the meaning of the statute because Dr. Kesling's use was an experiment and thus was an exception recognized by the Supreme Court in Elizabeth v. American Nicholson Pavement Co., 97 U.S. 126 (1877).

Under section 102(b), a public use of an invention causes the running of the one year period of limitations to commence. A public use within the statute is "any utilization of the invention by one other than the inventor where the user is under no limitation, restriction or obligation of secrecy to the inventor." Randolph v. Allis-Chalmers Manufacturing Co., 264 F.2d 533, 535 (7th Cir. 1959). See also Cloud v. Standard Packaging Corp., 376 F.2d 384, 390 (7th Cir. 1967); Watson v. Allen, 254 F.2d 342, 345 (D.C. Cir. 1958). If, however,

the inventor's public use is "experimental," then it is not a public use within the meaning of section 102(b). Cloud v. Standard Packaging Corp., 376 F.2d at 390; Hobbs v. Wisconsin Power & Light Co., 250 F.2d 100, 108 (7th Cir. 1957), cert. denied, 356 U.S. 932 (1958). Consequently, the first step in analyzing Pro's 35 U.S.C. § 102(b) assertion is to determine whether a public use occurred. If a public use is found, then the Court must ascertain whether the use was not a public use under the statute because it was experimental.

As indicated earlier, Pro's claim of public use arises out of Dr. Kesling having supplied positioners with precision seating springs to Nancy Furst, Shelia Rumely Brady, and Susan Spiers Elliott. Called as a witness for the defendant Pro, Dr. Harold Kesling

testified extensively concerning the appliances supplied to each of these patients.

The precision seating spring claimed in the patent was conceived in 1956. According to Dr. H. Kesling, the inventor, he first treated a patient using precision seating springs in 1958. Nancy Furst, a patient at the Kesling & Rocke Orthodontic Center where Dr. H. Kesling practiced, was initially fitted for a positioner equipped with the seating springs on July 21, 1958. Thereafter, on August 25, 1958, Ms. Furst was supplied with a new positioner possessing the seating springs. (DX 263(a); Tr. at 964-965). The positioner (DX 266) is of the design disclosed in figure 7 of the patent in suit. (Tr. at 965).

Although Dr. H. Kesling's testimony is less than definitive, apparently Sheila Rumely Brady was treated with a positioner using

precision seating springs beginning in early November, 1959. (DX 277; Transcript at 986-991). Her treatment with such a positioner was follow-up therapy to complete the positioning done by conventional means.

The next patient treated with a positioner utilizing precision seating springs was Susan Spiers Elliott. She was fitted on October 25, 1960 and the positioner was put into place on November 1, 1960. (DX 286; Tr. at 982-984).

Mrs. Spiers Elliott and Mrs. Rumley Brady were each paying customers. Ms. Furst did not pay. Her father was a dentist and, thus, Ms. Furst's treatment was a professional courtesy. Since the patent application for TP's patent was filed February 19, 1962, delivery of each of the positioners utilizing

precision seating springs occurred more than one year prior to application.

The burden of proving "public use" is on the defendant in a patent infringement case. He must establish the "public use" for more than one year prior to the patent application by clear and convincing proof. United States Gypsum Co. v. National Gypsum Co., 440 F.2d 510 (7th Cir. 1971); Julian v. Drying Systems Co., 346 F.2d 336, 338 (7th Cir. 1965). The evidence in this case clearly establishes use by at least three patients more than one year prior to the application date. Furthermore, these users were "under no limitation, restriction or obligation of secrecy to the inventor." Randolph v. Allis-Chalmers Manufacturing Co., 264 F.2d at 535. Certainly there is no evidence to the contrary and there is testimony to support such a finding. (DX 355 -

deposition of Dr. B.L. Furst (Nancy Furst's father) at 9; DX 356 - deposition of Susan Spiers Elliott at 7; DX 357 - deposition of Sheila Rumely Brady at 7). Consequently, the Court can only conclude that the patients were under no obligations of secrecy or for that matter any restrictions.

TP argues that these items were in secret because even the patients were not aware of the "testing." This is not significant. The plain fact is that the claimed invention was not kept secret. It was open to public observation without restriction which is sufficient to constitute "public use." See Egbert v. Lippmann, 104 U.S. 333 (1881). Furthermore, Dr. Furst was aware that the precision seating springs were a new device. (Exh. 355 - Dr. B.L. Furst deposition at 9). In addition, several of Mrs. Spiers Elliott's

associates saw the device. Consequently, the feigned secrecy relied upon by TP accords it no aid in claiming that the "use" was not "public."

TP argues further, however, that it is entitled to the experimental exception engrafted upon 35 U.S.C. § 102(b). 2 A. Deller, Walker on Patents § 145 (2d Ed. 1964). A use for experimental purposes is not a "public use" within the meaning of section 102(b) "if it is conducted in good faith for the purpose of testing the qualities of the invention and for no other purpose not naturally incident to that." Hobbs v. Wisconsin Power & Light Co., 250 F.2d at 108. See Cloud v. Standard Packaging Corp., 376 F.2d at 390; Randolph v. Allis-Chalmers Manufacturing Co., 264 F.2d at 535. The inventor bears a heavy burden of showing that the public use was bona

fide experimentation. Cloud v. Standard Packaging Corp., 376 F.2d at 390; George R. Churchill Co. v. American Buff Co., 365 F.2d 129, 134 (7th Cir. 1966); Koehring Co. v. National Automatic Tool Co., 362 F.2d 100, 104 (7th Cir. 1966).

The experimental exception is further limited in time. An inventor is only permitted a reasonable period of experimentation. George R. Churchill Co. v. American Buff Co., supra; Hobbs v. Wisconsin Power & Light Co., supra; Moraine Products, Inc. v. Block Drug Co., 318 F. Supp. 1064 (N.D. Ill. 1970). Whether or not the use was experimental is, however, a question of fact. Moraine Products, Inc. v. Block Drug Co., supra.

The experimental exception is unavailable to plaintiff TP for two reasons. First, the evidence presented does not establish that

the patentee was conducting a bona fide experiment. On the contrary, the record shows that the uses were random and poorly monitored. The only records kept by Dr. H. Kesling were the patient records. Dr. H. Kesling, the inventor, did not always evaluate how well the precision seating springs worked when the patients visited the clinic. Other doctors often made evaluations of performance. Furthermore, while the issue of experimentation is in effect a matter of the inventor's intent, in the present case the evidence indicates that his intent was not experimentation. In experimenting on a prior "invention," Dr. H. Kesling kept accurate records of the results of his experiments. In the present case, the records are scanty at best. (Tr. at 967).

It is important to note that the burden was on the plaintiff TP to show that use was a genuine experiment. Accurate records of the results of an experiment are certainly an indicia that the use was a bona fide experiment. In contrast the dearth of such records indicate that the use was not an experiment. The experimental use exception "is to be guarded closely." Atlas Chemical Industries, Inc. v. Moraine Products, 184 U.S.P.Q. 281, 283 (6th Cir. 1974). TP has simply failed to prove that the inventor, Dr. H. Kesling, was conducting a bona fide experiment.

Assuming, however, that the use was experimental, the delay in filing the patent application was unreasonable. The first use of the invention was in August of 1958. By April of 1959, Dr. H. Kesling knew that the precision seating springs operated as designed.

This was confirmed when he treated Susan Spiers and Sheila Rumely. Miss Spiers' positioner was placed in November of 1960 and Miss Rumley's was placed in November of 1959. Furthermore, the record card (DX 277) indicates the favorable results of the precision seating springs as early as February of 1960. Nevertheless, Dr. H. Kesling waited until February 19, 1962 to file his patent application. Significantly, the claimed invention disclosed in figure 7 of the patent in suit is substantially the same as the precision seating spring disclosed in the positioner (DX 266) supplied to Nancy Furst in August of 1958. Finally, Dr. H. Kesling, the inventor, himself testified that the precision seating springs supplied to Furst, Spiers and Rumely were substantially the same as those disclosed in

figure 7 of the patent in suit. (Tr. at 1039-40).

The delay here was unreasonable because the device proved satisfactory immediately. At least as early as 1960 Dr. Kesling learned that the invention was workable. At that point his time began to run under 35 U.S.C. § 102(b). Even if he had made minor improvements over the period, all this Court needs find is that the application was filed more than one year after the basic invention was disclosed within the meaning of section 102(b). Frantz Manufacturing Co. v. Phenix Manufacturing Co., 457 F.2d 314 (7th Cir. 1972). This Court is of the opinion that when an experiment tolls section 102(b), the one-year period of limitation commences to run when the invention disclosed proves workable. Improvements, though novel, which do not advance the basic

concept disclosed, do not toll the period of limitations. Id. at 320. The evidence indicates, however, that not even novel changes were made in the basic conception in public use in 1960.

Whether this Court finds the period of experimentation unreasonably long or that Dr. H. Kesling did not conduct a bona fide experiment, the public use, as found earlier, occurred more than one year prior to the filing date of the patent application. Under 35 U.S.C. § 102(b), this public use of the basic concept invalidates the patent in suit. The invention becomes prior art which invalidates the patent. See Dix Seal Corp. v. New Haven Trap Rock Co., 236 F. Supp. 914, 916-920 (D. Conn. 1964) quoted with approval in Illinois Tool Works, Inc. v. Solo Cup Co., 461 F.2d 265, 268 (7th Cir.), cert. denied, 407 U.S.

916 (1972). See also Frantz Manufacturing Co. v. Phenix Manufacturing Co., 457 F.2d at 321. In the Illinois Tool Works case, the court discussed the policy behind section 102(b) and then held:

Once in public use, [an] invention becomes prior art and as to all later discoveries in that field, anyone else must show some "patentable" change to obtain the legal monopoly. Once the year in which to prepare and file this application has passed, the employment of a standard of patentability less stringent against the first inventor than against these others would seem to impair, if not defeat, congressional policy. 461 F.2d at 270.

See also, Frantz Manufacturing Co. v. Phenix Manufacturing Co., 457 F.2d at 320. Having found public use and having held that no alteration occurred, or that if one was made it was not patentable, the public use invalidates the TP patent.

Since the patent in suit is invalid under section 102(b), the infringement issue is moot. Furthermore, the Court need not reach the alternative grounds for invalidation of TP's patent relied upon by defendant. The only substantive issue remaining is defendant's request for costs and attorney's fees.

Although not cited by defendants in their brief, attorney's fees may be awarded to a prevailing party in "exceptionable cases" under 35 U.S.C. § 285. Apparently, even though not clearly stated, defendants do not rely upon a claim of fraud on the Patent Office to support their request for attorney's fees but instead upon a claim of extreme lack of diligence in the conduct of discovery. The latter ground for attorney's fees was recognized and utilized by the Seventh Circuit Court of Appeals in L.F. Strassheim Co. v.

Gold Medal Folding Furniture Co., 477 F.2d 818, 824 (7th Cir. 1973). The question for this Court is whether the evidence presented indicates an "extreme lack of diligence." As conceded by defendant Pro, there is currently insufficient evidence before the Court for a resolution of the attorney's fee issue. Therefore, the Court will hold additional hearings on this issue after which a determination will be made.

Finally, the Court would note that plaintiff has moved to join Bristol Myers Company as a party defendant. Plaintiff's claim that Bristol Myers has succeeded to the interests of defendant Professional Positioners, Inc. by having merged with Pro. By stipulation and order, Professional Positioners, Inc., a Delaware corporation, was made a party defendant. The stipulation indicates that Profes-

sional Positioners, Inc., a Wisconsin corporation, merged with a corporation wholly owned by Bristol Myers, Delaware Unipro, Inc., a Delaware corporation. After merger, an amendment was filed to change the name of Delaware Unipro, Inc. to Professional Positioners, Inc., a Delaware corporation. The court's order joined Professional Positioners, Inc., a Delaware corporation. Bristol Myers, then, is the owner of the defendant Professional Positioners, its subsidiary.

In light of the above resolution of this case, there is no need to add Bristol Myers as a party defendant. Therefore, plaintiff's motion must be an [sic] hereby is denied.

In summary, plaintiff's patent is invalid under 35 U.S.C. § 102(b). Therefore, it is hereby ordered that plaintiff's action is dismissed on the merits.

It is further ordered that defendants' motion for costs and attorney's fees be held in abeyance pending further hearings. Pursuant thereto a status conference is scheduled for 9:30, Wednesday, April 2, 1980.

Finally, plaintiff's motion to add Bristol Myers as a party defendant under Rule 25(c) must be and hereby is denied.

SO ORDERED this 14th day of March, 1980,
at Milwaukee, Wisconsin.

Robert W. Warren
United States District Judge

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WISCONSIN

TP LABORATORIES, INC.,

Plaintiff,

vs.

Case No. 72-C-697

PROFESSIONAL POSITIONERS, INC.
a Wisconsin Corporation,
GERALD W. HUGE, and
RICHARD W. ALLESEE,

Defendants.

MEMORANDUM AND ORDER

On March 14, 1980, the Court entered an order holding that United States Patent No. 3,178,820 ('820), belonging to the plaintiff, TP Laboratories, Inc. (TP), was invalid under 35 U.S.C. § 102(b). The Court, however, did not rule on the defendants' request for attorney's fees or the defendants' counter-claim for harassment or abuse of process. In

addition, the plaintiff has recently filed a motion to vacate the Court's order of March 14, 1980 and to submit additional evidence. These unresolved issues are the subject of this memorandum and order.

MOTION TO VACATE

Plaintiff premises its motion to vacate on an allegation that the Court misapplied the law and ignored crucial evidence in holding that the patented device was open to the public and not experimental more than one year prior to the patent application. In addition, plaintiff has submitted affidavits from Dr. Peter Kesling and others which plaintiff alleges constitute newly discovered evidence. These affidavits present evidence which plaintiff contends refutes the Court's factual

findings regarding the issue of public use and experimentation.

Defendants oppose plaintiff's motion. They assert that the Court correctly applied the law and that its decision is completely supported by the record. Furthermore, they vigorously protest the submission of the additional affidavits because plaintiff has failed to show that the evidence is new or that it was unavailable at the time of trial. Defendants also contend that the evidence has always been available to plaintiff and that to allow additional evidence after the Court's decision would be unfair and would be inconsistent with the purposes of the trial system.

Under both Rules 59 and 60(b)(2) of the Federal Rules of Civil Procedure, the standard for reconsideration of a prior decision based on new evidence is the same. U.S. Fidelity

& Guarantee Co. v. Lawrenson, 334 F.2d 464, 465 (4th Cir.), cert. denied, 379 U.S. 869 (1964). The moving party must demonstrate that the evidence was in existence at the time of the trial and that in the exercise of due diligence, it could not be produced. Goland v. Central Intelligence Agency, 607 F.2d 339, 371 (D.C. Cir. 1978); Flett v. W.A. Alexander & Co., 302 F.2d 321 (7th Cir.), cert. denied, 371 U.S. 841 (1962); Stiers v. Martin, 277 F.2d 737 (4th Cir. 1960). Evidence in the possession of the moving party at the time of trial is not newly discovered evidence. 11 Wright & Miller, Federal Practice and Procedure, § 2589 n. 36.

In the instant case, plaintiff has failed to demonstrate that any of the additional evidence offered is newly discovered. Moreover, there is no doubt that this evidence was

in existence at the time of trial and within the plaintiff's control. Therefore, the Court finds no reason to consider the additional evidence of plaintiff.

The Court has also thoroughly reviewed its decision regarding the issue of public use and experimentation and finds no reason for any reconsideration of its decision. The arguments advanced by plaintiff have already been considered and rejected by the Court in its original decision of March 14, 1980. Nothing presented in the plaintiff's motion gives the Court cause for reconsideration. Therefore, plaintiff's motion to vacate the Court's order of March 14, 1980 must be and is hereby denied.

DEFENDANTS' REQUEST FOR
ATTORNEY'S FEES

Under 35 U.S.C. § 285, the Court is

authorized to award attorney's fees to the prevailing party in exceptional cases. In the Seventh Circuit, "exceptional cases" are not limited to situations where there has been a showing of fraud on the Patent Office. Rather, the Seventh Circuit has also used awards of attorney's fees to prevent gross injustice. Sarkes Tarzian, Inc. v. Philco Corp., 351 F.2d 557, 560 (7th Cir. 1965). Thus, the court has upheld awards of attorney's fees where a defendant exhibits an extraordinary lack of diligence in failing to make an investigation of public use or sale one year prior to the patent application, L.F. Strassheim Corp. v. Gold Medal Folding Furniture Co., 477 F.2d 818, 824 (7th Cir. 1973), where a defendant's testimony at trial was to disingenuous that it amounted to unreasonable conduct without legal justifica-

tion, Skill Corp. v. Lucerne Products, Inc., 503 F.2d 745 (7th Cir. 1974), and where a defendant acted inequitably in prosecuting a reissue application, Kearney and Trecker Corp. v. Giddings and Lewis, Inc., 452 F.2d 579, 597 (7th Cir.), cert. denied, 465 U.S. 1066 (1972).

The party seeking attorney's fees, however, bears a heavy burden of proof. In fraud cases, he must prove that there was fraud by clear and convincing evidence. Sarkes Tarzian, Inc. v. Philco Corp., 351 F.2d at 560. In other extraordinary cases, the misconduct complained of must be unambiguously shown. Airtex Corp. v. Skelly Radiant Ceiling Co., 536 F.2d 145, 155 (7th Cir. 1976).

Defendants base their claim for attorney's fees on the plaintiff's allegedly poor performance during the discovery phase of

this case. In particular, defendants assert: that the plaintiff failed to completely answer interrogatories nine and eleven; that plaintiff's present employees and officers gave false answers in their depositions regarding the existence of invoices for positioners sold by the plaintiff to Kesling & Rocke Orthodontic center; and that plaintiff failed to make an adequate search for certain records which the Court ordered them to produce for discovery.

In March of 1973, the defendants served their first set of interrogatories on the plaintiff. Interrogatory nine requested plaintiff to identify any prior art or sale or use of devices similar to the '820 known to the plaintiff or its employees prior to the filing date of the patent application. Interrogatory eleven inquired about the invention of the

patented device. In the numerous subparts to the interrogatory, defendants sought information regarding the sale of the invention, the testing period, the date of the first sale, the date of its reduction to practice, evidence or documents supporting these answers, and the names of individuals who could testify to the information requested.

In response to interrogatory nine, the plaintiff identified the prior art cited by the patent office and stated that the potential device was used experimentally prior to the filing of the application. The plaintiff did not, however, reveal the names of the patients who were provided with the experimental apparatus. Plaintiff's response to interrogatory eleven set the date of testing between 1958 and 1962 and set the date of the first sale at 1966. Furthermore, plaintiff

limited those with knowledge of the answers to Harold and Peter Kesling.

Later, at the deposition of Harold and Peter Kesling, as well as a number of their employees, defendants attempted to discover whether there existed any invoices or other records of sales to Kesling & Rocke of positioners with the patented device. Each time the question arose, the defendants stated that the plaintiff did not sell positioners to Kesling & Rocke. Dr. Harold Kesling did, however, testify at his deposition in May of 1975, that models and written records were retained for each patient and that such records would contain information relating to the use of seating springs. No records were produced. He also stated that he knew of no way it could be established what form of seating springs were used on a patient without a

patient record which he denied existed. Later, at least with regard to Nancy Furst, patient records and a model of the positioner were discovered.

Dr. Peter Kesling testified at his deposition on February 28, 1976, that TP Labs did not charge Kesling & Rocke for positioners and denied that there were any invoices for any of the positioners made for Kesling & Rocke. According to Dr. Peter Kesling, Kesling & Rocke was not a paying customer of TP Labs. Other representatives of plaintiff testified in their depositions that there were not records kept which predated 1970. See Deposition of Melvin Myers, Feb. 26, 1976.

This testimony was, however, contradicted by statements of Jean Squires who stated that she made a search of the record storage area known as the loft in 1970 or 1974 per

order of Dr. Peter Kesling. She was specifically searching [sic] for record treatment cards with notations that C's or seating springs were used. The records searched were prior to 1970.

Despite the assertions of plaintiff's employees, in the summer of 1976, two of plaintiff's employees discovered a number of invoices from TP Labs to Kesling & Rocke in the loft storage areas while Dr. Kesling was out of the country. These invoices were dated prior to the application for the patent and indicated that the plaintiff, in fact, billed Kesling & Rocke for the positioners it made. The invoice also indicated that in three instances positioners with the patented device had been sold to Kesling & Rocke one year prior to the application.

According to James Schultz, one of the employees involved in the search which revealed these records, the records were found behind a group of shelves in the loft. Mr. Myers was one of the employees who had earlier stated that no records were kept prior to 1970 and that the plaintiff never billed Kesling & Locke for positioners.

The plaintiff notified the defendants' counsel of the existence of the invoices sometime in August of 1976. This was also after the deposition of Norma Cook and Enid Happer, two former employees of plaintiff, who testified as to the existence of the invoices. At the time of Cook's deposition, Mr. Myers was aware of the existence of the new records, but did not reveal it, although he attended the deposition. Instead, he waited until Dr. Peter Kesling returned from Europe. Because

of the newly discovered evidence, the defendants requested and were granted additional time for discovery. Additional depositions of plaintiff's employees indicated that there had never been any concerted effort to look for the invoices or other records. Deposition of Warren Anderson, Dec. 14, 1976; Deposition of Dr. Peter Kesling, Dec. 14, 1976 at pp. 5-11.

Because plaintiff's employees and officers had originally denied the existence of these invoices, defendants were forced to conduct numerous depositions of former employees of the plaintiff, including Robert Harris, Mrs. Harlan Cook and Enid Happer. Each of these witnesses testified to the existence of the invoices and bills to Kesling & Rocke.

Defendants view the plaintiff's action as a deliberate attempt to avoid and hamper discovery. Therefore, they contend that the

Court should award attorney's fees in this case.

Plaintiff, in response to the defendants' argument, asserts that the invoices were unknown to the plaintiff's officers and employees before they were discovered. In addition, plaintiff states that the invoices were found by accident in a storage area in which the records would not ordinarily be expected to be found. Furthermore, plaintiff alleges that the invoices were not necessary to the Court's decision on the issue of public use.

With regard to the depositions of Harris, Cook and Happer, plaintiff asserts that the defendant Hug contacted each person prior to their deposition to refresh their memories. Further, TP claims that the defendants' intention in taking the depositions was

to amass evidence of public use of the patented C's or seating springs and that they were unsuccessful in doing so because the device was experimental and secret. Plaintiff also attempts to discredit their testimony by stating that they all swore that all positioners going to Kesling & Rocke were charged for when, in fact, one invoice demonstrates that there was no charge for an experimental positioner. Finally, plaintiff asserts that defendants' conduct in discovery delayed the progress of this case.

The Court has reviewed all of the pertinent discovery documents and testimony regarding the defendants' request for attorney's fees. On the basis of this review, the Court must conclude that the defendants have failed to demonstrate that this was an exceptional case under 35 U.S.C. § 285.

Although the abuses of discovery present in the record are serious, they are not as serious as the abuses in L.F. Strassheim Corp. v. Gold Medal Folding Furniture Co., 477 F.2d [sic] at 824. In L.F. Strassheim, the defendants failed to investigate the timeliness of its patent application and failed to turn over documents which clearly and convincingly demonstrated that their patent was invalid. If plaintiff in Strassheim had the documents it requested, it never would have had to go to trial or incur any other legal expenses. The failure to turn over the records resulted in an erroneous decision by the district court.

In this instance, the plaintiff's lack of diligence did not result in an erroneous decision, and the evidence was not withheld until after a trial on the merits. The plaintiff's actions delayed and impeded the pro-

gress of the case, but did not totally defeat the fact finding purposes of the trial. Although the Court did not decide the issue of prior sales, the invoices, as defendants suggest, are further evidence of the prior use of the patented device and thus support the Court's decision in that regard. Plaintiff must be held accountable for its lack of diligence and failure to thoroughly search its records, but a finding that this is an extraordinary case under 35 U.S.C. § 285 is not appropriate.

MOTION FOR ATTORNEY'S FEES
UNDER RULE 37(d) OF THE
FEDERAL RULES OF CIVIL
PROCEDURE

As an alternative to the award of attorney's fees under 35 U.S.C. § 285, defendants have requested attorney's fees under Rule 37(d) of the Federal Rules of Civil Procedure. That they did not make this request until

after the trial in this matter does not bar them from making the request now. Airtex Corp. v. Skelly Radiant Ceiling Co., 536 F.2d at 155. The Seventh Circuit in Airtex upheld an award of attorney's fees under rule 37(d) because plaintiff filed evasive and incomplete answers to interrogatories. The Court found that the plaintiff had violated its duty of cooperation and disclosure under the rule and that defendant had not waived any rights to fees even though it made its request for attorney's fees after trial.

Plaintiff argues that sanctions under rule 37(d) are not appropriate in this instance because: (1) the invoices were found accidentally; (2) the invoices were not crucial to the Court's decision; and (3) the plaintiff did not deliberately withhold the records. Defendants have expressed doubt as

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to the motives of the plaintiff and its lack of knowledge of the existence of invoices, and the evidence tends to support their allegations.

Even accepting plaintiff's counsel's statement that the invoices were accidentally found, the Court still finds good cause exists for awarding attorney's fees under Rule 37(d) of the Federal Rules of Civil Procedure. The purpose of the liberal discovery provisions in the federal rules is to ensure that parties will not be surprised by new evidence at trial. The rules also presuppose that each party will make a diligent effort to comply with the requests of the opposing party. When confronted with a claim that certain invoices existed, the plaintiff had a duty to make a thorough search of its records to determine if it had any invoices. Moreover, the testimony of

plaintiff's former employees should have alerted plaintiff to the possibility that its officers and present employees were mistaken in their denials of the existence of such invoices. It is important to remember that plaintiff's officers not only denied the present existence of the invoices, but they denied that any invoices were ever created. Rather than conducting a further search for the records after these depositions, plaintiff did nothing.

As the discovery of the records was accidental so was its fortuitous that the invoices were not crucial to the Court's resolution of the case. Plaintiff's failure to conduct a thorough search of its records in light of the conflicting deposition testimony and the Court's discovery order is a violation

of the purpose and spirit of the discovery rules.

Therefore, the Court finds defendants are entitled to attorney's fees and expenses for the depositions of Harris, Cook, and Happer, as well as the depositions of James Schultz, Mary Cleveland, Linden Wulf, Jean Squires, Melvin Myers, Warren Anderson and Peter Kesling, all taken on December 12, 1976. In addition, defendant is entitled to attorney's fees and expenses for its motion for extension of time for discovery filed on September 13, 1976, for its interrogatories filed on October 18, 1976 and November 24, 1976 and for its requests for admissions dated October 18, 1976 and December 30, 1976. All of these items of discovery were necessitated by the plaintiff's failure to make a thorough search of its records earlier. Defendants are

hereby ordered to file a detailed affidavit of the time spent on these items of discovery and the expenses incurred with the Court within 20 days of this order. Plaintiff may respond within 10 days thereafter.

HARASSMENT COUNTERCLAIM

Defendants contend that the Court should await a decision by the Court of Appeals for the Seventh Circuit before deciding their counterclaim for harassment. Defendants, however, also urge the Court to make a ruling regarding noninfringement of the patented device before any appeal is taken. Plaintiff, in response, asserts that defendants have no counterclaim for harassment or malicious prosecution because there has been no decision in their favor yet. Furthermore, plaintiff contends that the defendants' first counterclaim

does not state any cause of action for harassment or malicious prosecution or abuse of process. It also urges the Court to rule on the infringement issue.

The Court need not resolve any of these questions at this juncture. If any decision is necessary, it is best postponed until after any appeal of the Court's holding that the patent in suit is [sic] invalid. If that holding is upheld, the Court may have to reach the infringement issue. It is also possible, however, as plaintiff suggests, that defendants have not pleaded a counterclaim for malicious prosecution or harassment. In that event, the Court will not have to reach the infringement issue in this case. If the Court's decision is overruled, then the infringement issue will be decided in due course.

In summary, plaintiff's motion to vacate the Court's decision of March 14, 1980 is denied. Defendants' motion for attorney's fees under 35 U.S.C. § 285 is also denied. Finally, defendants' request for attorney's fees and expenses under Rule 37 of the Federal Rules of Civil Procedure is granted.

SO ORDERED this 10th days of June, 1981,
at Milwaukee, Wisconsin.

Robert W. Warren
United States District Judge

Case No. 83-1939

4

Supreme Court, U.S.
FILED

JUN 22 1984

ALEXANDER L. STEVAS
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1983

PROFESSIONAL POSITIONERS, INC., a Wisconsin corporation,
PROFESSIONAL POSITIONERS, INC., a Delaware corporation,
GERALD W. HUGE, RICHARD W. ALLESEE,

Petitioners-Defendants,

vs.

TP LABORATORIES, INC., an Indiana corporation,
Respondent-Plaintiff.

ON APPEAL FROM THE COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI

LLOYD L. ZICKERT
LEE, SMITH & ZICKERT
150 South Wacker Drive
Chicago, Illinois 60606
(312) 726-1982
Attorneys for Respondent-Plaintiff

Pandick Midwest, Inc., Chicago • 454-7600

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QUESTION PRESENTED FOR REVIEW

Was there a "public use" of the subject invention within the meaning of 35 U.S.C. § 102(b)?

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TABLE 1

Description of the study	
The study was conducted in the United Kingdom and involved 100 participants who were recruited from a local newspaper advertisement. The participants were divided into two groups: 50 in the experimental group and 50 in the control group. The experimental group received a 12-week intervention program, while the control group received no intervention. The intervention program consisted of a combination of physical exercise and cognitive-behavioral therapy. The physical exercise component involved three sessions per week of moderate-intensity aerobic exercise, while the cognitive-behavioral therapy component involved one session per week of individual therapy. The control group received no intervention and continued with their usual activities. The study was conducted over a period of 12 weeks, and the participants were assessed at baseline, 4 weeks, 8 weeks, and 12 weeks. The primary outcome measure was the change in the Beck Depression Inventory (BDI) score, which is a self-rated questionnaire that assesses the severity of depression. The BDI score ranges from 0 to 63, with higher scores indicating more severe depression. The secondary outcome measure was the change in the Hamilton Depression Rating Scale (HDRS) score, which is a clinician-rated questionnaire that assesses the severity of depression. The HDRS score ranges from 0 to 21, with higher scores indicating more severe depression. The results of the study showed that the experimental group had a significantly greater reduction in BDI score compared to the control group at 12 weeks. The mean BDI score for the experimental group at baseline was 28.5, and it decreased to 18.5 at 12 weeks. The mean BDI score for the control group at baseline was 28.5, and it decreased to 24.5 at 12 weeks. The difference between the two groups was statistically significant (p < 0.05). The results also showed that the experimental group had a significantly greater reduction in HDRS score compared to the control group at 12 weeks. The mean HDRS score for the experimental group at baseline was 18.5, and it decreased to 12.5 at 12 weeks. The mean HDRS score for the control group at baseline was 18.5, and it decreased to 16.5 at 12 weeks. The difference between the two groups was statistically significant (p < 0.05).	

IN THE
Supreme Court of the United States

OCTOBER TERM, 1983

PROFESSIONAL POSITIONERS, INC., a Wisconsin corporation,
PROFESSIONAL POSITIONERS, INC., a Delaware corporation,
GERALD W. HUGE, RICHARD W. ALLESEE,

Petitioners-Defendants,

vs.

TP LABORATORIES, INC., an Indiana corporation,
Respondent-Plaintiff.

ON APPEAL FROM THE COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI

REPORT OF OPINIONS

The opinion of the Court of Appeals for the Federal Circuit is additionally reported at 724 F.2d 965.

JURISDICTION OF THIS COURT

The reference to 28 U.S.C. § 210(c) should be 28 U.S.C. § 2101(c).

STATUTES INVOLVED

This case involves 35 U.S.C. § 102(b) as appearing on pages 1 and 2 of the petition and the following introductory portion of 35 U.S.C. § 282.

"A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity."

STATEMENT OF THE CASE

Jurisdiction in the District Court was based on 28 U.S.C. §1338 and the Final Judgment was entered on October 27, 1982, after the establishment of the United States Court of Appeals for the Federal Circuit, referred to as the Federal Circuit. Jurisdiction in the Federal Circuit is based on 28 U.S.C. §1295.

The patented invention is a tooth positioning appliance custom-fitted to a patient undergoing orthodontic treatment and wearable only by that patient. It consists of a molded resilient body having metal seating devices to enhance seating and retention of the appliance in the patient's mouth, thereby making the appliance much more effective than one not having the devices.

The District Court held the patent in suit invalid under 35 U.S.C. § 102(b) on the basis that the invention was in public use more than one year prior to the filing date of the patent application because of three uses which the Court held were not excepted under the experimental use doctrine. In its decision the Court relied on crucial findings of fact that the invention "proved satisfactory immediately" or "by April of 1959". (Appendix B pages 49-51) In its analysis of the experimental use issue, it held that the "inventor bears a heavy burden of showing that the public use was bona fide experimentation." (Appendix B pages 46-47)

The Federal Circuit not only found fault with the legal conclusions made by the District Court but also found fault with its findings of fact. It correctly applied the "clearly erroneous" standard to the fact findings but of course did not need to apply that standard to the legal conclusions.

In reaching its decision, the Federal Circuit clearly and accurately set forth the entire factual situation as supported by the evidence and which need not be repeated here. (Appendix B pages 4-10; 724 F.2d 966-68, Section I) Petitioners do not contest these facts. Next, the Federal Circuit carefully considers 35 U.S.C. § 102(b) its history and the analysis made by the District Court (Appendix B pages 13-17; 724 F.2d 968-70, Section IIA), concluding that the lower Court committed error in its legal analysis of the statutory and decisional law, and particularly that the shift in the burden of proof to the plaintiff led to an erroneous result. (Appendix B page 17; 724 F.2d 970)

It is at this point that the Federal Circuit, after observing that the District Court failed to follow the precedent of this Court in *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126, 24 L. Ed. 1000 (1877), stated that that decision is the "starting place for analysis of any case involving experimental use".¹ (Appendix B page 17; 724 F.2d 970)

The Federal Circuit next held that because "the statutory presumption of validity provided in 35 U.S.C. § 282 places the burden of proof upon the party attacking the validity of the patent, and that burden of persuasion does not shift at any time to the patent owner," it is incorrect for the District Court, in its analysis of the validity issue, to impose on the patent owner the burden of proving that a "public use" was "experimental". It then held that if a *prima facie* case is made that the invention

¹ Petitioners' contention on pages 16-17 of their brief that the District Court followed *Elizabeth* is not tenable as its only reference to *Elizabeth* is in connection with a statement concerning plaintiff's contention. (Appendix B pages 39-40)

was publicly used, the patent owner, if pleading such use to be experimental, must come forward with convincing evidence to show experimentation. (Appendix B pages 22-23; 724 F.2d 971) Contrary to petitioners' allegation, the Court did not require the challenger to have the burden of proving that the use is not experimental. (Appendix B page 22; 724 F.2d 971) Circuit Judge Nies, in a later decision, followed the same reasoning. *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd., et al.*, 731 F.2d 831, 839 (Fed. Cir. 1984). The Court then emphasized that it is necessary to consider the entirety of the evidence to determine whether there has been a "public use". (Appendix B page 23; 724 F.2d 972)

Thereafter, it applied the legal principles to which it is bound to the undisputed factual evidence. Agreeing with the District Court that the uses of the device prior to the critical date were non-secret, it held that such did not constitute "public use" activity.² (Appendix B page 24; 724 F.2d 972) It found that the *testing* of the device *had* to be public, which is in accord with the evidentiary testimony relating to that issue including that of co-defendants Huge and Allesee and which is entirely acceptable under *City of Elizabeth*, although recognizing that it was beyond "reasonable probability" that a patient would disclose the device to others who would understand its function. (Appendix B page 25; 724 F.2d 972) It noted that control over

² Even though the evidence clearly proved secret use by the inventor and his partners as to the orthodontic profession and commercial orthodontic appliance laboratories, petitioners contend that because of the single fact that patients custom-fitted with the invention were not sworn to secrecy, a fact deemed unimportant by the Federal Circuit, that activity was "public use". Both the District Court and the Federal Circuit rejected this contention but agreed the custom fittings were non-secret because of this single fact. (Appendix B pages 24-25; 724 F.2d 972) However, respondent submits the secrecy issue should be decided on the entire evidence, not by a single fact, and that the entire evidence overwhelmingly weighs in favor of secrecy.

the testing was maintained by the inventor, and held that the District Court's findings that the invention "prove satisfactory immediately" or "by April of 1959" were clearly erroneous. (Appendix B page 26; 724 F.2d 972) Finding that the testing paralleled that in *City of Elizabeth*, where the testing of the invention covered six years, it followed the rules set down there that the testing had to be conducted over a long period of time, and then held the testing by Dr. Kesling was experimental.

Significantly, the Court of Appeals finally observed that even though plaintiff had the facilities to commercially exploit the invention, it was not done. Concluding, it held that the defense of invalidity based on "public use" within the meaning of 35 U.S.C. § 102(b) was not proven by the defendants. (Appendix B page 29; 724 F.2d 972-73)

SUMMARY OF ARGUMENT

Federal Circuit case law is controlled by the law of its predecessor courts and the Supreme Court.

The petition is confusing as to the points requiring consideration, incorrectly states the factual evidence, rehashes over-used factual innuendos not supported by the evidence, and relies on non-authoritative case law. It clearly does not raise any substantial question for this Court.

Petitioners do not show that the Federal Circuit has violated any statute or authoritative decision in holding the burden of proving patent invalidity never shifts from the party attacking the patent.

Finally, the factual basis on which the Federal Circuit decision is based does not violate F.R.C.P. 52(a) because the facts relied upon are clearly supported by the evidence and are in accord with findings of the District Court, except where the "clearly erroneous" standard was applied with respect to crucial District Court findings.

ARGUMENT

The Federal Circuit Is Not Bound By The Decision Law of Other Circuits.

The petitioners overlook the purpose and responsibility of the Court of Appeals for the Federal Circuit which took form on October 1, 1982.

This Court, a merger of the Court of Claims and the Court of Customs and Patent Appeals, has among other appellate duties exclusive jurisdiction over patent appeals from the district courts.³ It is an Article III court at the same level as the existing twelve Circuit Courts of Appeal. The purpose of granting it jurisdiction over patent appeals was to eliminate the long identified forum-shopping and unsettling inconsistency in adjudications so that there would be nationwide uniformity.

The Court accepts, in its first published opinion, as precedent and binding the holdings of the Court of Claims and the Court of Customs and Patent Appeals. *South Corporation v. The United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982).

It is well established that each of the twelve regional appeal courts is not bound by the decisions of the others. The Federal Circuit, being a sister court and on an equal footing, is likewise not bound by the regional courts.

For good reason, scholars have already stated that the Court has far exceeded its expectations in producing well reasoned opinions, making patent litigation more predictable and eliminating expensive, time-consuming forum-shopping.

³ 28 U.S.C. § 1295(a)(1).

Neither The Statutes Nor The Case Law By Which The Federal Circuit Is Bound Deems The Burden Of Proof To Shift To The Patentee Where Experimental Use Is Involved.

The petition is replete with misrepresentations and unsupported, immaterial factual assertions and relies upon non-authoritative case law.

For example, petitioners' continued reference to "reduction to practice" misrepresents the facts and is not supported by the evidence or even a finding by the District Court. With respect to the evidence, petitioners are in error to state that plaintiff agreed that reduction to practice occurred in 1956. Perhaps more important, the District Court, not needing to reach the issue of reduction to practice, found that the invention was only conceived in 1956. (Appendix B page 42) Even so, experimental use following "reduction to practice" does not constitute "public use" activity.

It is conceded by petitioners that the doctrine of experimental use exists only in case law, as it is not in the pertinent statutes, 35 U.S.C. § 282 and 35 U.S.C. § 102(b). Likewise, they concede that there is no foundation in Section 282 for shifting the burden of proof to the patentee at any time. Section 282 clearly assigns the task of proving invalidity on the challenger. And petitioners do not point to any contrary authoritative case law.

Petitioners contend that circuit case law supports the proposition that once a use prior to the critical date is proven the burden of proof shifts to the patentee to prove it is experimental. They therefore complain that the Federal Circuit, in rejecting the concept of shifting the burden, is against the "current of authority" and reversed a long-standing rule. They further imply it creates a conflict that should be resolved. This reasoning is faulty since the Federal Circuit is now the only one with jurisdiction over patent appeals; it cannot create any

conflict with other circuits, and it is not bound by any "current of authority" from other circuits.

Further, as suggested by the petitioners in the selected case quotations on pages 6 to 12 of their brief, coming from only five circuits,⁴ the concept of shifting the burden of proof to the patentee to prove experimental use is thought to be founded in *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (1887). The Federal Circuit, while not being bound by this circuit law, rejects this view and astutely points out that even if the Court in *Smith & Griggs* intended to impose that burden on the inventor, it is untenable in view of the statutory presumption of validity subsequently enacted. (Appendix B page 32; 724 F.2d 971)

Moreover, the Federal Circuit emphasizes that the concept of shifting the burden of proof does not exist in the landmark *City of Elizabeth* case, which is the starting place for analyzing any case involving experimental use and which was followed in the later decided *Smith & Griggs* case, *supra*, pages 257-8.

Finally, the Federal Circuit made it abundantly clear that as against the backstop of the presumption of patent validity, under Section 282, the challenger has the sole burden of proving a defense including invalidity under Section 102(b). (Appendix B page 21; 724 F.2d 971) Maintaining the burden on the party attacking the patent squares with the precedent the Federal Circuit has already established. In *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1534 (Fed. Cir. 1983), the court stated:

"The presumption, like all legal presumptions, is a procedural device, not substantive law. It does require the decisionmaker to employ a decisional approach that starts with acceptance of the patent claims as valid and that looks to the challenger for proof of the contrary. Thus the party asserting invalidity not only has the procedural

⁴ Those cases finding "public use" do so *only* where commercial exploitation of the invention through sales is clearly present.

burden of proceeding first and establishing a prima-facie case, but the burden of persuasion on the merits remains with that party until final decision. The party supporting validity has no initial burden to prove validity, having been given a procedural advantage requiring that he come forward only after a prima-facie case of invalidity has been made. With all the evidence in, the trial court must determine whether the party on which the statute imposes the burden of persuasion has carried that burden."

The lucid treatment of the burden of proof issue by the Federal Circuit provides a single standard of placing the burden where it properly belongs in a similar fashion where it has soundly rejected other circuit court invented rules that lack statutory support, such as the requirement of synergism.⁵

The Federal Circuit Did Follow The "Clearly Erroneous" Standard.

It is contended by petitioners that the Federal Circuit altered the facts and violated the clearly erroneous standard of F.R.C.P. 52(a). Petitioners particularly single out the analysis of the patient record cards on page 25 of their brief. Yet, they do not point to a District Court factual finding relative to these cards which is not being followed by the Federal Circuit. Some of the facts recognized by the Federal Circuit relative to the patient record cards in evidence were not mentioned by the District Court, but they are clearly supported as seen by a mere review of the cards themselves, and such facts are not disputed by defendants and are material to the issue of experimentation. This cannot be considered to be fact alteration or disregard of Rule 52(a). However, it does suggest that the District Court failed to consider the entire material evidence when analyzing the case.

⁵ *Chore-Time Equipment, Inc. v. Cumberland Corporation*, 713 F.2d 774, 781 (Fed. Cir. 1983); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548-9 (Fed. Cir. 1983).

Petitioners' reference to Patent No. 2,531,222 is argumentative and of no probative value, as it was not discussed by the District Court or the Federal Circuit for the simple reason that it was not a material fact to the resolution of the "public use" issue. If the reference is meant to contend the patent shows "public use", that is absurd, and petitioner does not cite any authority to support the contention. Further, there is no connection between this point and the application of Rule 52(a).

With respect to those facts that are argued as being material and emanating from the District Court, they were found to be clearly erroneous by the Federal Circuit. (See Statement of Case, pages 4-5, *supra*)

Perhaps the most significant observation made by the Federal Circuit was that despite the fact that the inventor had readily available facilities for exploiting the invention on a commercial basis, that was not done. Surprisingly, this observation was not made by the District Court or even referred to in the face of overwhelming evidence supporting it and in view of argument by plaintiff that it was controlling. Further although vigorously contended otherwise by defendants, the District Court did *not* find any commercial exploitation or that the invention was sold prior to the critical date. This contrasts with the overwhelming commercial exploitation found in *Smith & Griggs* where over 7,000,000 buckle levers made from the patented machine were sold. A classic case of experimentation without commercial exploitation is *City of Elizabeth*. This case is identical in this respect, and the defendants have not seriously contended otherwise.

CONCLUSION

It is submitted that petitioners have not met the burden of showing any special and important reasons for granting review of this case. The question of conflict is not an issue, nor has the Federal Circuit departed from the accepted and usual adjudication proceedings. On the contrary, the Federal Circuit has by its opinion closely followed the pertinent statutes and the decision law of this Court. Their review and reference to the evidence comports with well established Appeals Court procedure. It is clear as so cogently reasoned by the Federal Circuit that petitioners have not proven a "public use" of the subject invention within the meaning of 35 U.S.C. § 102(b), and that petitioners therefore have not carried the burden of overcoming the statutory presumption of validity.

Accordingly, the petition for writ of certiorari should be denied.

Respectfully submitted,

TP LABORATORIES, INC.

LLOYD L. ZICKERT

LEE, SMITH & ZICKERT

150 South Wacker Drive

Chicago, Illinois 60606

(312) 726-1982

Attorneys for Respondent-Plaintiff